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IN THE
Supreme Court of the United States

October Term, 1976
No. 76-1425

MAURICE A. GARBELL, INC., and GARBELL RESEARCH
FOUNDATION, *Petitioners,*

vs.

THE BOEING COMPANY, *Respondent.*

and

MAURICE A. GARBELL, INC., and GARBELL RESEARCH
FOUNDATION, *Petitioners,*

vs.

MCDONNELL-DOUGLAS CORPORATION, *Respondent.*

On Petition for a Writ of Certiorari to the United States
Court of Appeals for the Ninth Circuit.

BRIEF IN OPPOSITION.

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BRIEF IN OPPOSITION.

INTRODUCTION.

The trial of these patent actions took up 56 days spread over three years; 1970, 1971 and 1972. The patent in suit, U.S. Patent No. 2,441,758, was applied for by Maurice A. Garbell over 30 years ago, and it expired 12 years ago. The cases were filed in the District Court 13 years ago.

During the pendency of the actions, the court file grew ten feet tall. Exhibits for each side number several hundred. The Findings of Fact, 385 F.Supp. 1-39, disposed of the issues. The law was properly applied (385 F.Supp. 1, 39-44), as the Court of Appeals for the Ninth Circuit confirmed (546 F.2d 297).

The courts below properly applied the controlling statutory and constitutional provisions as heretofore adequately laid down by the Supreme Court. There is no conflict of decision among the Circuit Courts, and there does not appear to be any issue of law requiring restatement by the Supreme Court.

Respondents submit, therefore, that no reason for granting a writ of certiorari exists.

The courts below followed this Court's decisions. See Conclusions of Law, 385 F.Supp. 1, 39-44, 546 F.2d 297. They held the patent in suit invalid since: it did not meet the test of novelty and utility as required by 35 U.S.C. Section 101; it was anticipated by prior art and thus invalid under 35 U.S.C. Section 102(a); the invention had been described in a printed publication on sale and in public use more than one year prior to the date of the application for the patent as contemplated by 35 U.S.C. Section 102(b); the subject matter of the patent was obvious to one skilled in the art and thus the patent was invalid under 35 U.S.C. Section 103; and the teachings of the patent were insufficient and the claims ambiguous under 35 U.S.C. Section 112. The courts below also found the case to be exceptional and awarded defendants reasonable attorney fees pursuant to 35 U.S.C. Section 285.

The Trial Court's Preliminary Findings and Memorandum Decision, its Findings of Fact and Conclusions of Law fully support its judgment (385 F.Supp. 1), and the substantial preponderance of evidence supporting each finding was documented for the Trial Court. [C.T. 3387, *et seq.*; 3485, *et seq.*; 3522-3554].

Questions Presented.

Should this Court grant certiorari to review the evidence in patent cases in which the issues were factual issues only and in which the law was then correctly applied to the facts?

Should this Court grant certiorari to review patent cases in which the courts below followed well-established rules laid down by this Court for determining invalidity of a patent?

Should this Court grant certiorari in patent cases in which the defendants were awarded compensation for a portion of their attorney fees where the patentee misled the Patent Office in obtaining the patent in suit and falsely testified in a prior action in obtaining a trial court decision of validity?

Should this Court grant certiorari in patent cases where the Garbell patentees came into these actions with "unclean hands", the Garbell patentees filed the actions for infringement of a patent they knew to be and they themselves helped prove to be invalid, the Garbell patentees never assessed their allegations of infringement prior to filing suit or to this day, the Garbell patentees withheld pertinent information from the Patent Office, the Garbell patentees used (and are still using) a prior decree obtained by Garbell's false testimony, and through it all, the Garbell

patentees have prolonged these actions beyond reason by their harassment and vexatious behavior?

The Statement which follows draws primarily on the testimony of Dr. Maurice A. Garbell, patentee and president of the two plaintiff corporations. Respondents submit that it demonstrates that the cases were correctly decided and that the cases do not meet the requirements of Rule 19 for granting certiorari.

History of Dr. Garbell's Inequitable Conduct. Dr. Garbell Suppressed Pertinent Facts From the Patent Office and Misled District Court Judge Yankwich in Obtaining the Earlier CVAC Decree.

Dr. Garbell Suppressed Pertinent Facts From the Patent Office and Claimed the Prior Art as His Own.

Over thirty years ago, on July 16, 1946, Dr. Garbell made application to the Patent Office praying for the grant of Letters Patent for an alleged new and useful invention of a "Fluid-Foil Lifting Surface" or wing which utilizes three or more airfoil sections.

In an Italian article published in 1938, Dr. Garbell's 16 year old colleague, Mr. G. Preti, wrote of the advantages of combining more than two airfoil sections in a wing. In Exhibit AI, Preti states:

"All airplane designers know the advantages which are obtained by the use of wings, the profile of which is not constant, but varies from root to tip." [Ex. AI; R.T. 535, 539].

On July 16, 1946, when Dr. Garbell applied for the '758 parent patent in suit, the following facts were known to him: (1) There had been *prior printed publications* describing the "Garbell Wing"; (2) There had been prior public use of the "Garbell Wing", and *public demonstrations* of sailplanes incorporating

the "Garbell Wing"; and (3) The "Garbell Wing" was *on sale* more than one year prior to the date of the '758 parent patent application and Garbell actively participated in those sales efforts. Dr. Garbell withheld these facts from the Patent Office.

In his oath to the Patent Office, Dr. Garbell swore that he was the original, first and sole inventor of the alleged invention or discovery described and claimed by him; he swore that he did not know and did not believe that the alleged invention was ever described in any printed publication in any county, or in public use or on sale in the United States for more than one year prior to the date of his patent application, *i.e.* July 16, 1945 [Ex. AU-1, p. 33; R.T. 224-226, 437]. Dr. Garbell's oath is false.

The Sailplanes Were Publicly Demonstrated and Were Described in Printed Publications.

In the '758 parent patent specification, Dr. Garbell states:

"Numerous flight tests and wind tunnel tests in reputable wind tunnels such as the California Institute of Technology, the Massachusetts Institute of Technology, the various wind tunnels of the National Advisory Committee for Aeronautics, and elsewhere have demonstrated convincingly that each of the objects of this invention has been fully achieved. The tests were performed on numerous wing models, on sailplanes, and on models of at least five aircraft designs of widely varying design scope employing a wide variety of airfoil series." [Ex. AU, Col. 10, lines 50 et seq.; Ex. AU-1, R.T. 224-225, 437; FF H9, 385 F.Supp. 1, 27].

The "flight tests" referred to were tests of sailplanes only, and the Pinguino sailplane was one of the references intended to be included by the use of the term "sailplanes" [R.T. 627-628; *FF H9*, 385 *F.Supp.* 1, 27].

At the time Dr. Garbell wrote the '758 parent patent application and took oath in the Patent Office, he knew the "sailplanes" referred to in the specification were not solely designed by him [R.T. 534-536]. In 1936, when he was a student in Milan, Garbell and a 16-year-old colleague by the name of G. Preti designed several sailplanes which incorporated wings defined by as many as four airfoil sections (from the root section to the tip airfoil section of each wing) [R.T. 269-272, 532-537, 619-631]. The students in Milan, including Garbell and Preti, built the "G.P." (Garbell-Preti designs) sailplanes, and when they completed building them, the students went out and took turns testing them in flight [R.T. 132-135, 273, 535, 627-629]. The "numerous flight tests" "performed on sailplanes" "employing a wide variety of airfoil sections" which "have demonstrated convincingly that each of the objects of this invention has been fully achieved" were the flights that the Milan students took in the "G.P." (Garbell-Preti) sailplanes in the years 1937 and 1938 [*Ex. AU*, the patent in suit, Col. 10, line 50 et seq., R.T. 132-135, 273, 535, 626-629; 437]. The sailplanes were publicly demonstrated by the Milan students at various Italian airports in 1937 and 1938, and both Garbell and Preti wrote articles describing the wing design features of these sailplanes. These wing descriptions appeared in printed publications and were circulated in Europe in the late '30s [*Exs. AC & AD*,

in ev. 7/15/70 at Special Master Hearing; *Ex. AE*, R.T. 347, 436; *Ex. AI*, R.T. 535, 539; R.T. 264, 266, 536).

Garbell Suppressed the Pertinent Prior Art Pinguino Sailplane Publications From the Patent Office. The Pinguino Has a "Garbell Wing".

The "G.P.1" which the Milan students named after a flightless bird, the Pinguino (or the "little Penguin") has special significance in this case and is pertinent prior art. Dr. Garbell testified in these actions that the Pinguino prior art wing achieved the same result as the wings covered by the claims of the '758 parent patent in suit [R.T. 273; 626-631]. Garbell knew that the sailplanes were not solely designed by him [R.T. 534-536], he knew they were described in printed publications in the late '30s, and he knew that what he claimed in the '758 parent patent application did not achieve any "unexpected results" over those sailplanes [R.T. 532-537, 619-631].

Dr. Garbell did not disclose to the Patent Office the printed publications describing the pertinent prior art Pinguino, Asiago and Arcore sailplanes [R.T. 269-270]. Garbell did not even cite to the Patent Office the sailplane publications that he, himself, had written and that he knew were published and circulated in 1938 [R.T. 269-270]. Garbell withheld and suppressed from the Patent Office the prior use of these sailplanes by the Milan students in public demonstrations in 1937 and 1938.

The printed publications and the public demonstrations directly affect patentability. Dr. Garbell had a duty to disclose this pertinent prior art to the Patent Office.

On August 5, 1946, two weeks after filing the '758 parent patent application, Dr. Garbell put CVAC, his former employer, on notice that it had come to Garbell's attention that CVAC was using his "well known method" of "safety wing design" [Ex. RM-3, p. 638; R.T. 726-729, 1084]. Garbell had been paid by Consolidated Vultee Aircraft Corporation ("CVAC") to work on wing designs during his employment by CVAC from September, 1942, until October 15, 1945.

After placing CVAC on notice as to the alleged invention claimed by Garbell in the '758 patent application, Garbell wrote letters to most, if not all, of the airframe manufacturers in this country and in Great Britain [Exs. RA, RB, RC, RF to RF-3, RH, RH-1, RI, RI-1, RJ, RJ-1, RK to RK-2, SF, SG; R.T. 277, 438; 279, 439; 306, 439; 513-514, 764; 2903, 3127; 845, 948; 3588, 3602; 2579, 2582; 2580, 2582] trying to interest them in using his alleged "safety wing design". The replies received by Garbell from the airframe manufacturers, including defendants Boeing and Douglas, stated that the subject matter of Garbell's alleged invention was old and unpatentable [R.T. 788-791].

One of the letters written by Garbell on August 6, 1946, to The Glenn L. Martin Company [Exs. RF, RF-1; R.T. 513-514, 764], prompted the response of William K. Ebel, Vice President Engineering, of The Glenn L. Martin Company [Ex. RF-2; R.T. 513-514, 764]. Mr. Ebel inquired of Garbell on August 21, 1946:

"In connection with your proposal, our patent department has raised the question of invention rights between yourself and Consolidated. Al-

though your letter indicates that you have a patent application filed in your name covering the development, it is not clear that you hold title to the invention to the exclusion of Consolidated. We would appreciate any information you are disposed to provide us in this connection." [Ex. RF-2; R.T. 513-514, 764].

When Garbell received that letter [Ex. RF-2; R.T. 513-514, 764], he had a problem—he was on the horns of a dilemma. He needed to show a reduction to practice of the claimed discovery in the '758 application for patent before he commenced his employment by CVAC in 1942.

On August 26, 1946, Garbell wrote to The Glenn L. Martin Company, Mr. William K. Ebel, Vice Pres. Eng., stating:

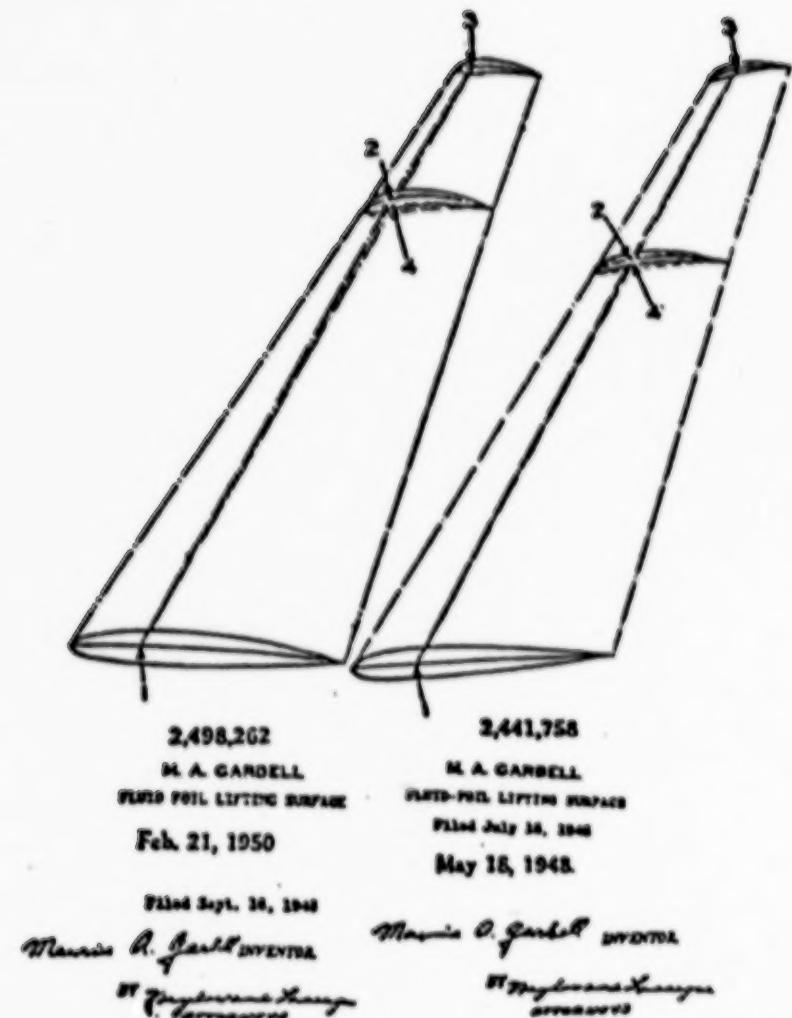
"Regarding my title to the said invention, I trust that the following information will clear up any question in your mind: (1) *The invention was conceived by me, first realized and test-flown, and further developed to its present state of fulfillment prior to my undertaking professional relationship with the Consolidated Aircraft Corporation;* (2) At no time did I assign the invention, or any part of it, to the Consolidated Aircraft Corporation, the Consolidated Vultee Aircraft Corporation, or to anyone else . . .". [Ex. RF-3; R.T. 513-514, 764].

After Garbell wrote to the Glenn L. Martin Company stating, in effect, that the sailplane designs were solely his own discovery or alleged invention since the Milan students' sailplanes were the only designs which were incorporated in an actual airplane and

"test-flown" prior to Garbell's "undertaking professional relationship with the Consolidated Aircraft Corporation" in 1942, Garbell went back to the Patent Office and specifically claimed the Pinguino sailplane by filing a "continuation-in-part" application and expanding his claims contained in the co-pending parent application which issued as the '758 patent in suit. [Exs. AU, AU-1, AV, AV-1; R.T. 239, 437; 245, 438; 270; Exs. AC AD, AE; Exs. AC & AD, in ev. 7/15/70 at Special Master Hearing; Ex. AE; R.T. 347, 436], Garbell expanded his claims to the alleged invention by filing a "continuation-in-part" application in the Patent Office on September 16, 1946, and claimed the Pinguino wing as part of his alleged invention disclosed in the co-pending parent application. [R.T. 619-621; Exs. AU-1, AV-1 in claim 3; R.T. 239, 437; 245, 438.] Again, Garbell did not disclose to the Patent Office the printed publications describing the Pinguino wing design [R.T. 269-270].

Just for the sake of comparison, the Pinguino prior art wing claimed by Garbell in U.S. Patent No. 2,498,262 ('262 CIP) patent and depicted by Garbell in the '262 patent; and a depiction of one of the wings claimed by Garbell in the '758 patent and illustrated in the '758 patent in suit [Exs. AU, AV; R.T. 239, 437; 245, 438] are herein set forth on the following page.

The pertinence of the Pinguino sailplane wing as prior art is not now open to doubt. The prior art Pinguino sailplane is the FOUNTAINHEAD of the "Garbell Wing". The Pinguino wing is the same in elements, function and result to that claimed by Garbell in the '758 patent in suit.



(Left) THE PRIOR ART PINGUINO WING CLAIMED IN THE '262 CIP PATENT.
(Right) A WING SHOWN IN FIG. 1 OF THE '758 PARENT PATENT IN SUIT.

**The Prior Art Pinguino Sailplane Is the Fountainhead
of the "Garbell Wing".**

Further comparison shows that:

1. Figure 2 of the '262 CIP patent is identical to Figure 2 of the '753 patent. [Exs. AU, AU-1, AV, AV-1; R.T. 239, 437; 245, 438]. In designing the Pinguino prior art wing, Garbell and Preti made the same sketch as that depicted in Figure 2 of both these patents [R.T. 532-536].

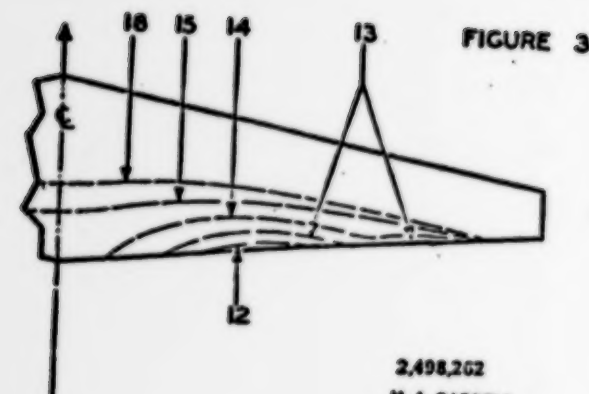
2. The principles of the alleged invention were fully demonstrated in the Pinguino prior art wing as stated in the specifications of both the '758 patent and the CIP '262 patent [Ex. AU, Ex. AV; R.T. 239, 437; 245, 438].

3. As depicted in Figure 3 of both patents [Exs. AU and AV; R.T. 239, 437; 245, 438], the intended results, which Dr. Garbell likes to call the "Garbell Stall", are the same.

Garbell testified [R.T. 273] that the Pinguino prior art wing achieved the same result as the wings covered by the claims of the '758 patent in suit and in the Pinguino Patent No. 2,498,262 which issued to the Garbell plaintiffs on February 21, 1950 [Exs. AU, AU-1, AV, AV-1; R.T. 239, 437; 245, 438].

On May 18, 1948, the '758 patent in suit issued to Dr. Garbell. On February 21, 1950, the '262 CIP Pinguino patent issued to Dr. Garbell.

By taking oath in the Patent Office to the general effect that the Pinguino prior art wing design, *publicly demonstrated* was not described in printed publications in the late '30s, Garbell was granted the '758 patent and the '262 "continuation-in-part" patent [Exs. AU-1, p. 33, AV-1, p. 26; R.T. 239, 437; 245, 438].



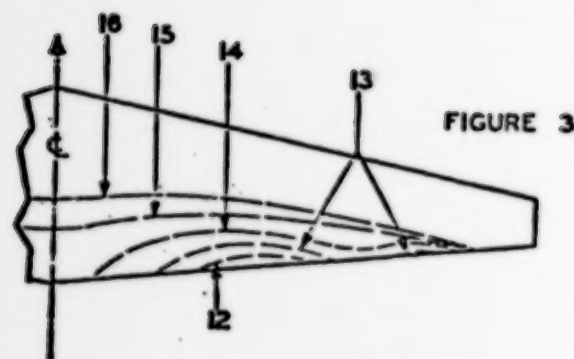
2,498,262
M. A. GARBELL
FLUID FOIL LIFTING SURFACE
Feb. 21, 1950

Filed Sept. 18, 1948

Maurice A. Garbell INVENTOR

BY *Thompson & Thompson*
ATTORNEYS

(Above) GARBELL STALL USING
PRIOR ART PINGUINO WING
CLAIMED IN THE '262 CIP PATENT.



2,441,758
M. A. GARBELL
FLUID-FOIL LIFTING SURFACE
Filed July 18, 1948
May 18, 1948

Maurice A. Garbell INVENTOR

BY *Thompson & Thompson*
ATTORNEYS

(Above) GARBELL STALL SHOWN
IN FIG. 3 OF THE '758 PARENT
PATENT IN SUIT.

The Garbell Patentees' Reliance on the Earlier CVAC Decree Is Unfounded. Garbell Misled District Court Judge Yankwich, the Trier of Fact in the CVAC Action.

The '758 patent was previously litigated in this District in an action by the Garbell corporations against Garbell's former employer, Consolidated Vultee Aircraft Corporation (hereinafter called CVAC), and CVAC's purchaser, American Airlines, Inc. (Civil Action No. 10930-Y, 1950.) *Maurice A. Garbell, Inc., et al. v. Consolidated Vultee Aircraft Corp., et al.*, 94 F.Supp. 843, reversed 204 F.2d 946, cert. denied 346 U.S. 873.

The CVAC record and testimony, especially that of Dr. Garbell, was presented to the Trial Court in the present actions and it is in evidence as Exhibits RM-1 through RM-5 [R.T. 833-834, 1084]. Garbell's testimony in the present actions, proves that Garbell actually knew facts which would have invalidated the '758 patent, 385 F.Supp. 1, 26-30, but he did not disclose them to the Trial Court in the CVAC action. Evidence that Garbell testified untruthfully before District Judge Yankwich and suppressed facts within his knowledge which would have rendered the '758 patent invalid is outlined herein.

In the 1950 Trial, Garbell Misled District Court Judge Yankwich on the Prior Art Pinguino Statutory Bar.

In November of 1950, at the four-day trial of the Garbell plaintiffs vs. CVAC and American Airlines, the defendants presented to the trial court the printed publications describing the Pinguino sailplane. The sailplane publications were uncovered by the defendants CVAC and American Airlines without the aid of Dr. Garbell.

Despite the fact that the '262 *Pinguino* Patent had issued to Garbell on February 21, 1950, Garbell did not disclose this fact to the Trial Court in the CVAC action when he testified before Judge Yankwich in November of 1950, eight months later. The defendants in the CVAC action presented to District Judge Yankwich the prior printed publications describing the Pinguino design, but Garbell suppressed the fact that the Pinguino was claimed by him as a "continuation-in-part" of the alleged invention claimed by him in the '758 patent [CVAC R. Tr. 197-202; Exs. RM-1, RM-2; R.T. 833, 834].

The testimony of Garbell goes on to mislead Judge Yankwich into believing that the Pinguino wing design, if used on a powered airplane, was not feasible and even dangerous:

"Q. Could you have used the Pinguino wing on a powered-driven plane, other than maybe a powered glider?"

"A. (GARBELL) I don't quite understand that, a powered glider?"

"Q. Well, in a very, very light weight low powered plane, could you have used a Pinguino wing?"

"A. (GARBELL) Yes, if the craft was powered merely to the extent of flying at the speeds at which the Pinguino was intended to glide. But if the speeds were to exceed that characteristic gliding experience of the Pinguino, that would not have been feasible."

"Q. Would it set up such a twist in the wing that it was liable to tear it off or destroy it?"

"A. (GARBELL) Well, it would have done that . . ." [CVAC R. Tr. 197-199; Exs. RM-1, RM-2; R.T. 833, 834.]

At no time during the CVAC trial, did Garbell disclose to District Judge Yankwich the fact that he had been issued the '262 CIP patent, the fact that he claimed the Pinguino wing in Claim 3 of the '262 CIP patent, or the fact that the Pinguino wing was identical in elements, function or result to that claimed by him in the '758 patent. Garbell misled District Judge Yankwich in his testimony to the effect that the Pinguino wing could not be utilized on a powered airplane when *he knew* at the time he testified before Judge Yankwich *that in the Specification of the '262 CIP Pinguino patent* that had issued in February of 1950, *he had stated:*

"This invention accomplishes an important improvement in the art, and *the discoveries herein disclosed are of great value to all types of aircraft* (as well as to craft operating on other fluids), *throughout their entire operating range, . . . ; also in violent maneuvers at high speeds . . .*". [Ex. AV, Col. 8, lines 58-68; R.T. 239, 438.]

Garbell swore before District Judge Yankwich that from the wing design of the Pinguino, as described in printed publications circulated in the late 30s:

"There is a need for an inventive effort, with the description, from the description of the Pinguino or any other description of the Pinguino to this wing." [CVAC R.T. 137; Exs. RM-1, RM 2; R.T. 833, 834.]

"Further, Garbell swore to Judge Yankwich that from the published Pinguino wing description, *'that description could not have been applied to obtain a usable wing for a high-speed or highly loaded airplane'*" [CVAC R.T. 137; Exs. RM-1, RM-2; R.T. 833, 834].

From these same prior printed publications on the Pinguino wing design, the Special Master was able to make geometry findings on the Pinguino wing [C.T. 2652-2653; Exs. AC and AD in evidence at the trial before the Special Master]. Garbell finally admitted on March 9, 1972, at the trial in these actions, *that he claimed*, in Claim 3 of the '262 CIP patent application, *the wing of the Pinguino* [R.T. 619].

Garbell Did Not Make a Full and Fair Disclosure of All the Pertinent Facts to the Patent Office or to the District Court in the CVAC Action. Garbell Suppressed All the Facts and Disclosed Only Half the Facts to Each Tribunal.

Thus, in obtaining his claims in the '758 patent and in the '262 CIP patent, Garbell suppressed the prior printed publications describing the Pinguino wing. When he testified in the CVAC action, Garbell suppressed the '262 CIP patent in which he claimed the Pinguino wing design. Garbell prevented the Patent Office and District Judge Yankwich from properly functioning in their duties by suppressing pertinent facts from both the Patent Office and the Trial Court Judge in the earlier CVAC action. Neither the Patent Office, nor District Judge Yankwich had before it *both* the Pinguino prior printed publications and the '262 CIP Pinguino patent at the same time. The Patent Office knew what Garbell was claiming, but did not know of the printed publications. Trial Judge Yankwich knew about the prior publications on the Pinguino, but did not know about the '262 Continuation in part Pinguino patent. Garbell did not make a full and fair disclosure of *all* the pertinent facts to the Patent Office or to the District Court in the CVAC action. Garbell suppressed *all* the facts and *disclosed only half the facts* to each tribunal.

The District Court's Findings [F. of F. H5 to H17, N13 to N15; 385 F.Supp. 1 at 27-38] of the Garbell plaintiffs, and Garbell's own behavior, are: "Such conduct is below the standards of good faith and candor in inventors . . .". The District Court's findings could not have been different. The record in the present actions is replete with evidence that Dr. Garbell testified untruthfully in the CVAC trial.

The following are highlights of the testimony of Dr. Garbell in obtaining the earlier CVAC decree compared with the testimony and evidence presented at the trial in these actions. The comparison proves that the Garbell plaintiffs' reliance on the earlier CVAC decree is unfounded. Dr. Garbell came into these actions with "unclean hands".

From the time the Garbell plaintiffs filed the present actions in 1963, at all times during the period these cases were pending, and now in their Petition for Writ of Certiorari, the Garbell plaintiffs have made use of the early decree of validity in the action of *Maurice A. Garbell, Inc., and Garbell Research Foundation v. Consolidated Vultee Aircraft Corporation and American Airlines*, 94 F.Supp. 843 (S.D. Cal. 1950); reversed at 204 F.2d 946; cert. denied 346 U.S. 873, 74 S.Ct. 122, 98 L.Ed. 381; ultimately dismissed with prejudice. In addition to the use of the CVAC decree in the District Court [C.T. 328-386, 654, 1560, 1594, 1913-1915], and in the Ninth Circuit (*App. Br., No. 74-1017*), the Garbell plaintiffs continue to use the CVAC decree in their Petition for Writ of Certiorari as a justification for coming into the present actions with "unclean hands", and as a justification of patent validity (*Pet. for Writ of Cert., pp. 3, 4, 6, 8, 9, 11, 12, 16*). In essence, the Garbell plaintiffs state that because

the Ninth Circuit Court of Appeals, in reversing the CVAC case, "did not tell the patent holders that they did not possess a valid patent", that somehow the patent is still valid. Plaintiffs further state, "nothing occurred between 1950 and 1963 to disabuse the patent holders of their understanding that their patent was and is valid" (*Pet. for Writ of Cert., p. 11*). The Garbell plaintiffs ignore the testimony of Dr. Garbell in obtaining the CVAC decree.

Garbell's Sworn Testimony Changes as the Issues Change.

Dr. Garbell's testimony has changed as the issues have changed. When the issue was "shop rights" in the CVAC action, Dr. Garbell claimed he did no wing design work at CVAC [*Exs. RM-1 and RM-2, CVAC R. Tr. 415-416, 432, 459, 833, 834*]. After testifying before Judge Yankwich that he did no wing design work at CVAC [*R.T. 3569 to 3571*], Dr. Garbell appeared as an expert on aerodynamics in the case of *Lockwood v. Piper Aircraft* [*Ex. 50; R.T. 650, 3581, 3598*] at which time he stated, again under oath, that he did the work of the entire aerodynamics group at CVAC, and also that he had supervised the CVAC divisions at San Diego, Downey and Detroit. When the issue was "whether Dr. Garbell was the sole inventor", Dr. Garbell testified that he did extensive wing design work at CVAC [*Exs. 203-1 thru 203-11; R.T. 3323, 3326; Ex. 702; R.T. 3376 to 3539*]. Before Judge Yankwich, Garbell testified that he did not work out "the details of how to make a wing of this kind and present the details to Consolidated in detail, at their expense" [*R.T. 3569-3571*]. When the issue was "operability", Dr. Garbell stated [*Exs. AU, AV*] that the Pinguino sailplane demon-

strated convincingly that each of the objects of the "Garbell Wing" had been fully achieved, and in the oath accompanying the application for the patent, Dr. Garbell swore that the invention had not been described in printed publications, although the Pinguino had been fully described in printed publications in Europe during the late '30s [Exs. AC & AD, in ev. 7/15/70 at Special Master Hearing; Ex. AE, R.T. 347, 436].

The XB-46 Airplane Wing Was on Sale and Sold Prior to the Critical Date. Contrary to Garbell's 1950 Testimony, the XB-46 Had a 3-Section Wing, Later Patented by Garbell.

At the trial in the present actions, Dr. Garbell testified that he had charge of the XB-46 wing design— aerodynamic design, while employed by CVAC. He "proposed the shape of the wing" and convinced "higher-ups" to ultimately adopt his "configuration". He "wrote the proposal for the Government". He made sure "that proposal was carried over into the wind tunnel model". He knew that the loft lines defining the actual B-46 airplane wing conformed to his configuration, i.e., a 3-section wing [R.T. 637-650, 944-946, 3546-3547, 3370]. Yet, when "shop rights" was an issue in the CVAC case, Dr. Garbell testified before Judge Yankwich:

"Q. And did they ever build an XB-46 while you were employed by them?"

"A. (Dr. Garbell) No, the only thing they had was a full-sized mock-up, that is, one to determine spaces, etc., and the mock-up wing, I looked at it very closely in the experimental factory, had a 2-section wing." [CVAC Tr. 459, Ex. RM-2; R.T. 833-834].

Dr. Garbell knew of the sales competition in which the XB-46 airplane incorporating a wing covered by the claims of the '758 patent in suit competed. Garbell testified in the present actions that no change was made to the wing shape described in the specification submitted to the Government and incorporated in the wind tunnel wing or the full-scale aircraft [R.T. 3370, 3546-3547; Ex. 203-7; R.T. 3324, 3326; Ex. GN; R.T. 943]. The wing of the actual XB-46 airplane corresponds to the wind tunnel wing which Garbell saw being tested at the NACA Ames Laboratory [R.T. 637-650, 944-946, 3370, 3546-3547] in May of 1945.

The evidence and testimony in these actions proves that Dr. Garbell's wing configuration employed in the wind tunnel wing and the full-scale aircraft is covered by claims 1, 2, 3 and 7 of the '758 patent [R.T. 634]. The wind tunnel wing, the mock-up and the data describing that wing were sold to the Government, and title passed prior to July 16, 1945. Payment was made to CVAC on the contract which included the purchase of the wind tunnel wing (\$94,200), the mock-up (\$183,125), and the data describing that wing (\$211,200) [Ex. GT-1, p. 4, R.T. 939; Ex. GT, R.T. 766; Ex. GI, R.T. 913; Ex. HW, R.T. 2411; 2438; Ex. GN, R.T. 943]. And in April of 1945, the Government required CVAC to make its data on high speed jets such as the XB-46 available to other contractors [Ex. BO]. In view of the fact that Garbell was still employed by CVAC until October, 1945, and in view of his testimony in these actions, he had to know that CVAC was going to use the "Garbell Wing" on the XB-46. Yet, Dr. Garbell swore to District Court Judge Yankwich:

"Q. They never told you they were going to use your 3-section wing on that XB-46?"

"A. (Dr. Garbell) No." [Ex. RM-1, RM-2, p. 459; R.T. 833, 834].

As an aside, the CVAC testimony *now relied upon as true* by the Garbell plaintiffs regarding his efforts in selling the XB-46 is that of CVAC in their motion for a new trial, not Dr. Garbell's testimony [C.T. 3734-3735].

Re Garbell's 3-Section Tailless: Contrary to Garbell's 1950 Testimony, Garbell's 3-Section Tailless Wing Was on Sale, Disclosed to the NACA, a Public Body, and Used by the NACA in 1943-1944.

In May 1944, Dr. Garbell was directly involved in selling "Garbell Wings" which he patented two years later.

Dr. Garbell testified at the trial of these actions that the data reports describing his alleged invention, incorporated in the "tailless" had been distributed to the Navy in the period of April and May of 1944 [R.T. 784], and that he went "alone" to meet with Captain Diehl of the Bureau of Aeronautics in an attempt to sell his tailless "design" (later patented) to the Navy in May of 1944 [R.T. 389], more than two years prior to applying for the '758 patent.

Dr. Garbell stated that the data on his alleged invention was available to any contractor from Captain Walter Diehl, Bureau of Aeronautics, Navy Department, Washington 25, D.C. [Ex. SM; R.T. 3561-3598].

In addition to seeing Captain Diehl on that trip, Dr. Garbell disclosed his alleged invention of the three-section wing design to Ira Abbott of the NACA; and

the NACA distributed a description of the wing to its various research facilities [Ex. 686; R.T. 3558, 1582], well before the critical date.

In *Exhibit SM*, R.T. 3561, 3598, dated October 8, 1946, and authored by Dr. Garbell, he states that his alleged invention was tested at Langley Field NACA Free-Flight Tunnel for almost a year and that "exceedingly complimentary comments were received from the NACA and the Bureau of Aeronautics" on his "safety wing design". Thus, Garbell knew at the time he wrote *Exhibit SM*, on October 8, 1946, that the data on his alleged invention had "been prepared for the Bureau of Aeronautics in 1943 and 1944", and he knew this data was circulated in NACA, a public body, R.T. 1582, 1600-1601, 784, 3558; C.T. 3750, 3753, from whom Dr. Garbell wrote he had received "exceedingly complimentary comments" on the alleged invention claimed in the '758 patent.

Garbell knew that he had placed no restrictions on the NACA, and he could not have placed any restrictions on the NACA. As Mr. Ira H. Abbott stated to the Trial Court with reference to the NACA memorandum [Ex. 686; R.T. 1582] of Garbell's disclosure to the NACA:

"Q. Were any restrictions placed on NACA personnel by the contractors with respect to dissemination of the materials contained in a memorandum such as this?"

"A. (MR. ABBOTT) Absolutely not."

"Q. Do you understand that question, Mr. Abbott?"

"A. (MR. ABBOTT) Yes I understand the question and, of course, there were no such re-

strictions placed. Sometimes we placed restrictions on the contractor's representative, but there was no authority for them to place any restriction upon our employees." [R.T. 1606].

The disclosed design is covered by claims 1, 2, 3 and 7 of the '758 patent; and is included in Convair Report ZA-101, "approved" by Garbell [R.T. 393, 402-404; Ex. DW; R.T. 393, 441].

Garbell testified before Judge Yankwich that he disclosed only a two-section wing design to the Navy. He testified that he did not try to sell a tailless airplane to the Navy which incorporated his allegedly invented wing design of "three, or more, sections", but that he had only tried to sell "the idea of a tailless design" [CVAC R. Tr. 189-190, 431; Exs. RM-1, RM-2; R.T. 833, 834].

Contrary to his statements in Exhibit SM and Exhibit 1 to his Affidavit [C.T. 3750], Dr. Garbell swore before Judge Yankwich that the NACA at Langley Field tested only a 2-section wing [CVAC R. Tr. 438; Exs. RM-1, RM-2; R.T. 833, 834].

On appeal in the present actions, the Garbell plaintiffs took a completely new stand on Garbell's sales activity in attempting to sell his tailless "safety wing design" to the Navy (*Reply Br.*, pp. 21-22). In their Reply Brief, dated August 1, 1975, more than thirty years after Garbell's sales trip to Langley Field, the Garbell plaintiffs stated that it was not Garbell's "tailless" at all, but that Garbell attempted to sell to the Navy a "tailless" patented by two other inventors.

The "Poor-Man's Garbell Wing" Was Described in an NACA Prior Art Printed Publication.

The pertinence of Garbell's visit to Captain Walter Diehl and the NACA at Langley Field in May of 1944, is that the essence of the "Garbell Wing" had been published and was well known more than one year prior to his patent application. This knowledge was imparted through reports and publications by Garbell himself, as well as by other aeronautical engineers and the National Advisory Committee on Aeronautics.

A wing which Garbell referred to as "a Poor-Man's Garbell Wing" was described in a printed publication more than one year before the patent application was filed.

Dr. Garbell referred to the modified XB-36 wing, the one which is covered by Claim 11, as "a poor-man's Garbell". Garbell, in fact, took pains to attribute the design to Mr. Abbott [R.T. 907-908], for the purpose of tracing the lineage of the design to Garbell's discussions with Abbott at Langley [Ex. 686; R.T. 1582]. NACA Report No. L5B23 (meaning Langley, 1945, February 23rd) disclosing the NACA work on the modified XB-36 wing was published by the NACA in February 1945, as Mr. Sivells testified [R.T. 2363-2393]. The testimony of Mr. Thomas Neill [R.T. 2020-2029], and the NACA records [Exs. SD1-SD10; R.T. 2020, 2029], proves that the Wartime Report on the modified B-36 wing [Ex. KF; R.T. 1348, 1396], was released and available to government contractors in March 1945. During Garbell's deposition he was asked "did you have access to the Wartime Reports prepared by NACA while you were at Convair?" He answered: "Some, yes. Those pertinent to my work." [Ex. HT, p. 361; R.T. 774, 826, 1083].

The modified B-36 had a stall progression pattern similar to that shown in the patent [R.T. 2370, 2371, Ex. AU, Fig. 3]. Dr. Garbell acknowledged that the modified wing "did show the effectiveness of that airfoil configuration in some improvement of the stall." [R.T. 908].

Contrary to Dr. Garbell's oath to the Patent Office, and his testimony before District Court Judge Yankwich, the "Garbell Wing" was described in printed publications, was in public use and on sale all more than one year prior to the date of the '758 parent patent application. In spite of Garbell's misconduct in the Patent Office and his going into the CVAC action with "unclean hands", the Garbell patentees proceeded into these actions in 1963, and maintained them to this date.

The Garbell Plaintiffs Came Into These Actions With "Unclean Hands". Garbell Is Using an Unlawful Monopoly Unlawfully.

Respondents submit that the foregoing highlights the fact that the Garbell plaintiffs came into these actions with "unclean hands" and that Garbell has demonstrated a reckless disregard for the truth. These actions were not filed or maintained in good faith. It would be unconscionable to require the defendants to bear the burden of their defense cost since (1) the Garbell plaintiffs filed the actions for infringement of a patent they knew to be, and they themselves helped prove to be invalid, (2) they withheld pertinent information from the Patent Office, (3) they used, and are still using, a prior decree obtained by Garbell's false testimony, (4) they came into these actions with "unclean

hands", and (5) through it all, they have prolonged these actions beyond reason.

Garbell plaintiffs acted in bad faith in bringing these actions in 1963, for alleged infringement of the '758 patent they knew to be invalid and not patentable over the prior art. They prolonged the litigation doubtless to extort settlement money from the defendants. They failed to assess their infringement allegations against defendants in the nine years these two cases were pending in the District Court [Ex. HT, p. 124; R.T. 774, 826, 1083; R.T. 858-859, 879-880; C.T. 3485 et seq.]. By their delaying tactics, they frustrated the Special Master [C.T. 3485 et seq.], the Trial Court, and the defendants in trying to move these cases to a final determination in trial before the District Court. (District Court's Preliminary Findings and Memorandum Decision, 385 F.Supp. 1, at 2-9, 37-38).

That the '758 patent is invalid and should not have been issued in the first place is clearly set forth in the District Court's Preliminary Findings and Memorandum Decision, Findings of Fact and Conclusions of Law. (385 F.Supp. 1-57.) Record support for the Court's findings can be found in Defendants' Post Trial Summary of Facts. [C.T. 3387, et seq.] Additional record support for the District Court's findings is at Clerk's Transcript, pages 3528-3554.

The Plaintiffs Set Out to Avoid Trial on Validity.

From the time the Garbell plaintiffs filed these actions in 1963, they have made use of the earlier CVAC decree of validity [C.T. 328-386, 654, 1560, 1594, 1913-1915] doubtless to avoid a validity trial in the present actions and a consideration of the testimony

and evidence relied upon by the District Court Judge Yankwich in making that decree [*R.T. June 2, 1972*].

In January of 1970, the Garbell plaintiffs made a motion to expand the existing reference to the Special Master and requested a trial before the Special Master on the geometry of certain prior art wings and the geometry of the allegedly infringing wings [*C.T. 1307; 1335; 1338; 1341; 1449, 1557, 1582*]. This trial before the Special Master was requested to take place at a time when these actions were scheduled to move to trial before the District Court [*C.T. 1128, 1152, 1154*]. Their motion was granted by the Trial Court [*C.T. 1609, 1610*]. The actual determination of the issues of validity and infringement was reserved for trial before the District Court, as was the determination of the aerodynamic significance of the Special Master's geometry findings [*C.T. 1609, 1610*].

The Curtiss-Wright Model 21B and Model 23 Airplane Wings Anticipate the Claims of the Patent in Suit.

The trial before the Special Master commenced in June of 1970, and lasted 30 days, including closing arguments. The Special Master's original Report was filed with the District Court in December, 1970 [*C.T. 2285, et seq.; 2498, Court Exhibit 1; R.T. 69*]. The geometry findings of the Special Master rendered the '758 patent invalid [*Garbell: R.T. 848*].

In early 1971, a hearing was held in the District Court on the objections of both parties to the Original Report of the Special Master [*C.T. 2409, 2419*]. After considering the parties' objections to this Original Report [*Court Ex. 1*] and following a hearing on their objections [*C.T. 2406, 2407, 2408, 2497, 2533, 2534, 2771*], the District Court modified the Special

Master's Original Report by interlineation and filed it [*C.T. 2285, 2534, 2771*]. While the Garbell plaintiffs bitterly opposed the modifications made to the Original Report and, in fact, asked the Court for summary judgment of validity of the '758 patent based on the Special Master's Original Report [*C.T. 2348, 2393, 2433, 2474, 2500*], the plaintiffs later presented the Court with evidence [*Exs. 695-11 and 695-11A; R.T. 2706, 2764*] which supports and justifies the modifications made by the District Court. The geometry findings of the Special Master set forth in the Original Report, as modified by the Court, are supported by the evidence presented to the Special Master and outlined by him in the Report. The Curtiss-Wright prior art wing geometry, as found by the Special Master, is covered by the claims of the '758 patent and anticipates those claims. 385 F.Supp. 1, 19. Thus, the trial before the Special Master, requested by plaintiffs, resulted in findings that rendered the '758 patent invalid. The Trial Court's modifications to the Original Report [*Court Ex. 1; R.T. 69*] are supported by plaintiffs' own evidence [*Exs. 695-11 and 695-11A; R.T. 2706, 2764*].

At the eventual trial before the Court in 1972, the plaintiffs offered no evidence contrary to that offered by defendants on the Curtiss-Wright prior art wings. Astonishingly, the Garbell plaintiffs placed into evidence, without limitation, an exhibit that, without more, supports the Special Master and District Court findings which invalidate the '758 patent by anticipation. [*Exhibits 695-1 through 695-71A, especially Exs. 695-11, 695-11A; R.T. 2697 to 2764.*]

The plaintiffs' evidence, an internal Curtiss memo, dated August 18, 1948, states:

"Subject: Garbell Patent 2,441,758. We know of no Curtiss-Wright airplane, *except* the prior art airplanes referred to below which could be construed as coming within the scope of his (Garbell's) patent." (*Exhibit 695-11; R.T. 2706, 2764.*)

This memo (*Exhibits 695-11, 695-11A; R.T. 2706, 2764*) outlines the Curtiss development and then goes on to fully verify that the CW-23 and the CW-21B wings anticipate the claims of the '758 patent. Plaintiffs' convincing evidence contained in this exhibit summarizes the depositions of former Curtiss engineers George A. Page taken in March, and again in June of 1967; Charles Hurkamp, taken in July of 1967; R. F. Driefke, taken in June of 1967; pilots: Ned Warren, taken in June of 1967 and William Nickey, taken in June of 1967; and summarizes the testimony before the Special Master in 1970, consisting of George A. Page, Wesley T. Butterworth, Prof. Pinkerton, Donald A. Schelp and Lyman D. Smith; refutes the lengthy Garbell testimony before the Special Master and summarizes the trial testimony of Butterworth.

Plaintiffs' evidence on the Curtiss-Wright prior art wings additionally states and proves:

"This wing was modified still further on two other Curtiss-Wright models, the 21B and 23, to a form which would appear to anticipate at least some of Garbell's claims. Attached hereto are reproductions of six pages of an Aerodynamics Report dated February 20, 1939 which discloses the form of the Model 23 wing. Because the new root section used in this model, designated the CW-

23 airfoil, had zero camber and the tip (the CW-19 section) had only slightly more camber than the airfoil at the splice (N.A.C.A. 2314), the camber at the latter was greater than that which would have resulted from straight line fairing between root and tip."

The memorandum was put into evidence without limitation [R.T. 2706, 2764] and proves that the Model 21-B and 23 wings had zero camber at the root as found by the Special Master and had the elements of claims 1, 2, 3 and 7 as found by the court. 385 F.Supp. 1, 20. The memo continued:

"There was also aerodynamic improvement along the lines referred to in Garbell's patent. This improvement (as recently computed from flight test data on the CW-23 airplane tabulated in 1939) indicates an increase in maximum lift. . ."

Also, while there appears to be no comparative flight test data directly on point, *it is understood that the flight characteristics of the 21B and 23 model were improved by reason of using the further modified wing.*" (*Exs. 695-11 and 695-11A; R.T. 2706, 2764.*)

Exhibits 695-11 and 695-11A; R.T. 2706, 2764 additionally prove that details and reports on the Curtiss Wright prior art wings were readily retrievable as late as 1948, and originals of proposals such as P-248 (*Ex. JX-19; R.T. 1233, 1248*) were available for use in Court in the '70s. For prior art use, the Curtiss-Wright Models 23 and 21-B have never been lost or forgotten.

The Curtiss-Wright prior art wings had an identity of elements, function, and result to that claimed by Garbell in the '758 patent in claims, 1, 2, 3 and 7. In view of all the evidence, the Court could not have found otherwise. [*Findings of Fact F1 through F22; 385 F.Supp. 1, 18-21.*]

**In 1971, the Garbell Plaintiffs Earnestly Set Out
to Avoid Trial.**

The plaintiffs in 1971 set out in earnest to avoid trial on validity.

On February 1, 1971, the Court set the cases for trial in the District Court for the actual determination of the issues of validity and infringement as well as the determination of the significance of the geometry findings of the Special Master [*C.T. 2407-2408*].

During the weeks before the trial, the plaintiffs filed several motions for continuance which were denied [*C.T. 2548; 2555; 2561; 2615; 2618; 2623; 2631*].

On May 5, 1971, the Special Master filed his Supplemental Report [*C.T. 2634*] and, on May 14, 1971, the plaintiffs took the occasion to move to remand for further findings by the Special Master claiming they were *surprised by their own evidence* presented to the Special Master and contained in the Supplemental Report [*C.T. 2708; 2733; 2741; 2778; 2801; 2833; 2929; 2934; 3485 et seq.*]. The Court granted their motion [*C.T. 2771; 2777; 2974*].

By June 1, 1971, the Garbell plaintiffs had successfully avoided a validity trial in these actions for eight years. On June 1, 1971, they were still unwilling to go to trial in the District Court on the issue of validity of the '758 patent, an issue common to both the Boeing action and the Douglas action.

In eight years, plaintiffs were not prepared to go to trial on the infringement allegations against Douglas. They had failed to assess their infringement allegations [*Ex. HT, p. 124; R.T. 774, 826, 1083*] and claimed they were surprised by their own evidence presented to the Special Master on the geometry of the allegedly infringing DC-8 wing [*C.T. 3485 et seq.*]. They had made no effort to assess their infringement allegations in the Boeing action in the eight years that case had been pending [*R.T. 858-859, 879-880; Ex. HT, p. 124; R.T. 774, 826, 1083*].

Unwilling to proceed to trial on the validity issue and unprepared to go to trial on the infringement issues, the Garbell plaintiffs attacked the Trial Judge personally for alleged bias and prejudice in a motion filed on the first day of trial, June 1, 1971 [*C.T. 2978, 2994, 3050*]. Amazingly, this assault on District Judge Hauk was filed just one year subsequent to their expressed desire filed with the District Court [*C.T. 2076-2077*] "that the Court hold these actions without further transfer" to a new judge. After urging the Trial Judge Hauk to "hold these actions" because they had been transferred so many times since 1963, the plaintiffs in 1971, used a recusal motion to hound the Court to transfer the cases.

On June 4, 1971, after three days of trial, the Garbell plaintiffs filed with the Ninth Circuit an all-out attack on the Trial Judge in a Petition for Writ of Mandamus (*Ninth Circuit Case No. 71-1856*).

The plaintiffs further prolonged a final adjudication of the validity of the '758 patent by applying for and obtaining a stay of the trial pending review of their Petition for Writ of Mandamus [*C.T. 3057*].

The plaintiffs' success was short-lived, their petition was denied the same day it was argued [*C.T.* 3062, 3063, 3065, 3067].

With very little success in the Ninth Circuit Court, the plaintiffs filed a Petition for Writ of Certiorari in the United States Supreme Court (*Case No. A-556, October Term, 1971*), asking for a stay in this Court, and not succeeding made a further try in the Ninth Circuit [*C.T.* 3285].

The Garbell Plaintiffs' Misconduct Is Unmistakable.

In the fall of 1971, after the stay of the Circuit Court was lifted, and the mandate went back to the District Court [*C.T.* 3062], the plaintiffs fired their two patent attorneys [*C.T.* 3102, 3106, 3128, 3133, 3146, 3160, 3171] and further prolonged the litigation in these cases. Plaintiffs represented to the Court that they had no competent patent counsel [*C.T.* 3321, 3330], and Morris Lowenthal, Esq., plaintiffs' counsel since 1965, stated that he was not competent to try these actions [*Hearing 9/10/71; C.T.* 2090; 3069; 3093; 3105]. Examples of the frustrations experienced by the Special Master [*C.T.* 3485 *et seq.*], the Trial Court, and the defendants in trying to move these cases to a final determination in trial before the District Court are, in part, set forth in the District Court's Preliminary Findings and Memorandum Decision [*C.T.* 3557, *et seq.*; and 385 *F.Supp.* 1, at 2 to 9, 37-38].

The conduct of the Garbell plaintiffs, their lack of cooperation and refusal to communicate with the Special Master, and their refusal to prepare for or attend a short evidentiary hearing on the remand sought by them and granted by the Court, caused the Special Master to report to the District Court as follows:

Special Master Letter No. 95, dated November 18, 1971:

"I concede also that I think the difficulty imposed upon any attorney or firm [defendants] required to stand by indefinitely, but always at the ready, pending plaintiffs' obtaining trial counsel they think adequate to the task, is utterly intolerable."

Special Master Letter No. 100, dated December 30, 1971:

"I cannot refrain from observing that the delays incurred in bringing this phase of the litigation to a close have been intolerable and are in large part attributable to unwarranted demands that counsel and Dr. Garbell be inconvenienced in the prosecution of the litigation which plaintiffs commenced."

The next letter from the Special Master was written at a time when these cases were simultaneously pending (1) hearing on the remand requested by the Garbell plaintiffs, (2) pending recommencement of the trial in the District Court, (3) in the Ninth Circuit seeking a second stay of trial of the actions [*C.T.* 3285] commenced by plaintiffs, and (4) in the United States Supreme Court on plaintiffs' Petition for Writ of Certiorari and their application to that Court for a stay.

Special Master Letter No. 102, dated February 1, 1972:

". . . We have the astounding situation in which: plaintiffs desire to defer indeterminately any hearing pertaining to the geometry issues which, by their motion and the Court's order, were made

a matter of reference to me as Special Master; and defendants are anxious to have the matter heard and determined at the earliest possible time. My own view of the matter is that plaintiffs' counsel are entirely competent to represent plaintiffs in the action, that there are no serious prospects to (if, indeed, there are any serious endeavors to obtain), substitute counsel for plaintiffs and that, if plaintiffs' counsel have the time and energy to generate the copious paperwork recently filed with the respective clerks of the District Court, the Court of Appeals and the Supreme Court, they can find the time and energy to attend a short hearing before me."

The plaintiffs, in February of 1972, then had put the defendants in this position: (1) the defendants had to prepare the trial set to recommence on March 7th, knowing all the while that plaintiffs would apply for, and possibly obtain, a stay of trial in the United States Supreme Court and (2) the defendants were forced at the same time to prepare for the scheduled Special Master hearing, even though plaintiffs had no intention of showing up.

On February 14, 1972, the Supreme Court denied the plaintiffs' stay application and, eventually, denied certiorari. The remand to the Special Master was vacated [*C.T.* 3325, 3485] and plaintiffs showed up for trial with Mr. George B. White and Mr. Morris Lowenthal as attorneys of record.

Trial recommenced on March 7, 1972, and concluded on June 2, 1972. The trial which commenced June 1, 1971, was finally completed June 2, 1972, including final argument by both parties. The Court, in consider-

able detail, rendered a tentative decision from the Bench on June 2, 1972. [*R.T. of June 2, 1972, C.T.* 3484.]

Proposed findings were submitted to the Court by defendants, objections to these proposed findings were filed by plaintiffs.

On September 14, 1973, defendants filed a notice of motion and motion *re* amount of attorneys' fees to be awarded to defendants. [*C.T.* 3496.]

Hearing on defendants' motion, plaintiffs' objections to that motion [*C.T.* 3508, 3517] and defendants' reply to the objections [*C.T.* 3522] was heard on October 1, 1973 [*C.T.* 3556]. At the Hearing, defendants presented testimony of Herbert A. Huebner, Esq. Mr. Huebner testified that these cases are "exceptional" within the meaning of 35 U.S.C. Section 285, and that \$850,000 is reasonable attorneys' fees for the 18,525 hours in legal work necessarily performed by the firm, Hahn, Cazier, Hoegh & Leff, in the defense of these actions [*R.T. Oct. 1, 1973*].

Thereafter, the Trial Court modified the proposed Findings of Fact and Conclusions of Law, and made its own Preliminary Findings and Memorandum Decision. (385 *F.Supp.* 1 through 57).

Final Judgment was filed and entered in both cases pursuant to Rule 54(b) of the Federal Rules of Civil Procedure [*C.T.* 3731].

The District Court made Findings on the "Justification for an Award of Attorneys' Fees" (385 *F.Supp.* 1, at 37); and concluded from these findings and the testimony of Mr. Huebner [*R.T.* 10/1/73] that these cases are "exceptional" within the meaning of 35 U.S.C. Section 285 (385 *F.Supp.* 1, at 44).

In Garbells' Motion to Alter or Amend the Judgment [C.T. 3732, 3742] they were not seeking relief from the judgment of invalidity of the '758 patent. In their motion and proposed order amending judgment, the plaintiffs were willing to accept the judgment of attorneys' fees, but asked the District Court to reduce the award of "reasonable" attorneys' fees to defendants to \$2,500.00.

Since the Garbell corporations' major asset is the '758 patent which expired in 1965 [C.T. 170] and was never commercially exploited during its life, it is unlikely that defendants could ever be compensated by the Garbell plaintiffs for costs alone, much less collect an award of attorneys' fees for the 18,525 hours in legal work and litigation necessarily incurred and performed in the defense of these two cases from 1965 through 1973. The \$850,000.00 in attorneys' fees for the 18,525 hours in legal work by defense counsel, Hahn, Cazier, Hoegh & Leff, was reduced by the District Court to one-fourth the amount prayed for by defendants. The award of "reasonable" attorneys' fees is now fixed in the amount of \$237,062.50 by the District Court. The Garbell patentees cannot now be heard to say that the decision of invalidity should not stand or that these cases are not "exceptional".

REASONS FOR DENYING CERTIORARI.
The Courts Know an "Exceptional" Case When They See One.

35 United States Code §285 could not be simpler:

"The court in exceptional cases may award reasonable attorney fees to the prevailing party."

Section 285 needs no restatement by this Court. The courts below *know* an "exceptional" case when they see one. In finding cases to be "exceptional", the courts follow well established principles laid down by this Court.

The facts make the present actions "exceptional":

1. Dr. Garbell owed a duty to the Patent Office to make a full and fair disclosure of all facts affecting the patentability of his "Garbell Wing" invention, and Dr. Garbell breached his duty;

2. Dr. Garbell suppressed from the Patent Office relevant evidence of prior printed publications describing the "Garbell Wing" incorporated in the Pinguino sailplane, and signed an oath that the claimed invention had not been described in printed publications; although he himself described the alleged invention in printed publications in the late '30s;

3. Dr. Garbell went into the CVAC action with "unclean hands", and deliberately misled District Court Judge Yankwich in obtaining a validity decree in *Maurice A. Garbell, Inc. v. Consolidated Vultee Aircraft Corporation, et al.*, 94 F.Supp. 843 (D.C. Cal. 1950), reversed 204 F.2d 946, cert. denied 346 U.S. 873, 74 S.Ct. 122;

4. The Garbell plaintiffs came into these actions with "unclean hands", and have made use of the

CVAC decree obtained by Dr. Garbell's false testimony in the CVAC action;

5. The Garbell plaintiffs did not make a reasonable assessment of their allegations of infringement prior to filing suit in these actions to enforce an obviously invalid patent, and refused to assess their infringement allegations when ordered by the Special master to do so;

6. The Garbell plaintiffs "improvidently brought" these actions in 1963, they unduly and deliberately fought against going to trial, and they unduly prolonged these actions far beyond any concept of a civil case in any court, let alone a federal court.

From the facts presented in these actions, the trial court found, "N17. The conduct of plaintiffs as outlined in these findings is wholly unjustified and amounts to bad faith. It would be unconscionable to require defendants to bear the burden of their defense cost." (*Maurice A. Garbell, Inc. v. Boeing Company*, 385 F.Supp. 1, 38 (D.C. Cal. 1973).

In Finding Cases to Be "Exceptional", the Courts Below Follow Well Established Principles Laid Down by This Court.

In affirming the trial court in these actions, the Ninth Circuit Court of Appeals followed well established law as laid down by this Court:

"A patent applicant owes a duty to the patent office to make a full and fair disclosure of all facts which may affect the patentability of his invention. *Precision Instruments Manufacturing Co. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806, 818, 65 S.Ct. 993, 89 L.Ed. 1381 (1945). A breach of that duty is relevant not

only in determining the validity of the patent but also the good faith of the applicant in maintaining subsequent infringement actions. *Monolith Portland Midwest Co. v. Kaiser Aluminum and Chemical Corp.*, 407 F.2d 288 (9th Cir. 1969); *Kramer v. Duralite Company, Inc.*, 514 F.2d 1076, 1077 (2nd Cir. 1975)." *Maurice A. Garbell, Inc. v. Boeing Co.*, 546 F.2d 297, 300 (9th Cir. 1976).

As stated by this Court:

"A patent by its very nature is affected with a public interest. As recognized by the Constitution, it is a special privilege designed to serve the public purpose of promoting the 'Progress of Science and useful Arts.' At the same time, a patent is an exception to the general rule against monopolies and to the right to access to a free and open market. The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope." *Precision Instrument Mfg. Co. et al. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806, at 816, 65 S.Ct. 993, 89 L.Ed. 1381 (1945). "(I)t is clear that Automotive knew and suppressed facts that, at the very least, should have been brought in some way to the attention of the Patent Office, especially when it became evident that the interference proceedings would continue no longer. Those who have applications pending with the Patent Office or who are parties

to Patent Office Proceedings have an uncompromising duty to report to it all facts concerning possible fraud or unequity underlying the applications in issue. *Cf. Crites, Inc. v. Prudential Ins. Co.*, 322 U.S. 408, 415, 64 S.Ct. 1075, 1079, 88 L.Ed. 1356. This duty is not excused by reasonable doubts as to the sufficiency of the proof of the inequitable conduct nor by resort to independent legal advice. Public interest demands that all facts relevant to such matters be submitted formally or informally to the Patent Office, which can then pass upon the sufficiency of the evidence. Only in this way can that agency act to safeguard the public in the first instance against fraudulent patent monopolies. Only in that way can the Patent Office and the public escape from being classed among the 'mute and helpless victims of deception and fraud.' *Hazel-Atlas Glass Co. v. Hartford-Empire Co.*, 322 U.S. 238, 246, 64 S.Ct. 997, 1001, 88 L.Ed. 1250." *Precision Instrument Mfg. Co. et al. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806, 818, 65 S.Ct. 993, 999, 89 L.Ed. 1381 (1945).

The facts in these actions and the testimony of Garbell himself, as highlighted herein, prove that the "Garbell Wing" monopoly springs from a "background" saturated with Garbell's bad faith and willful acts of inequitable conduct; if not, indeed, fraud itself.

The Equitable Powers of This Court Can Never Be Exerted in Behalf of One Who Has Acted Fraudulently or Who by Deceit or Any Unfair Means Has Gained an Advantage. To Aid a Party in Such a Case Would Make This Court the Abettor of Iniquity.

Contrary to the Garbell Petitioners' statement (*Pet.*, p. 8), that the trial court "did not find that the acts of Dr. Garbell before the Patent Office were wrongful or willful or that there was any fraud on the Patent Office"; in a detailed tentative decision [*R.T. June 2, 1972, pp. 181-210*], the trial court stated: (1) that Dr. Garbell sat down and claimed all the prior art in his patent application as a method of extorting monies from the aircraft manufacturers [*R.T. 198*]; (2) that Dr. Garbell did not disclose to the Patent Office the prior art Pinguino or Arcore sailplanes [*R.T. 198-199*]; (3) that Dr. Garbell did not disclose to the Patent Office the prior art printed publications describing the Pinguino sailplane wing [*R.T. 198-199*]; (4) that Dr. Garbell's suppression of the prior art printed publications from the Patent Office was "some indication of fraud upon the Patent Office" [*R.T. 198*]; (5) that Dr. Garbell's testimony in these actions is contrary to his testimony before Judge Yankwich in the CVAC case [*R.T. 198-199*]; (6) that "I do feel that Judge Yankwich did not have all the evidence before him as I do". "If he had, I think Judge Yankwich might well hold the patent invalid as I am doing." [*R.T. 199*]; (7) that the Garbell plaintiffs "improvidently brought" these

actions [R.T. 209]; (8) that the Garbell plaintiffs unduly prolonged these actions far beyond any concept of a civil case in any court, let alone a Federal Court [R.T. 209]; and (9) that the Garbell "plaintiffs unduly and deliberately fought against going to trial although they were plaintiffs" [R.T. 209].¹

As noted by the Ninth Circuit Court of Appeals (*Maurice A. Garbell, Inc. v. Boeing Co.*, 546 F.2d 297, 299-300),

"The court found that the essence of the Garbell Wing had been published and was well known more than one year prior to his patent application. This knowledge was imparted through reports and publications by *Garbell himself* as well as by other aeronautical engineers and the National Advisory Committee on Aeronautics."

* * *

"Additionally, the court found that the Garbell Wing was on sale more than one year prior to the date of the patent application and that *Garbell actively participated in those sales efforts.*"

* * *

"Specifically, the court found that *Garbell had misled the patent office* by suppressing relevant evidence of prior publications, 385 F.Supp. at 38 (Findings N13-N15, N17) . . .". *Maurice A. Garbell, Inc. v. Boeing Co.*, 546 F.2d 297, 299-300 (9th Cir. 1976).

The trial court found that Garbell's conduct in the Patent Office, "is below the standards of good faith

¹Judge Yankwich's quotation in *Maurice A. Garbell, Inc. v. Consolidated Vultee Aircraft Corp.*, 94 F.Supp. 843, 845 applies to Dr. Garbell's conduct throughout. "(L)ike the 'damned spot' in Macbeth, will not 'out', for all adjurations."

and candor required of inventors dealing with the Patent Office". *Maurice A. Garbell, Inc. v. Boeing Company*, 385 F.Supp. 1, 38 (D.C. Cal. 1973), and:

"N17. The conduct of plaintiffs as outlined in these findings is wholly unjustified and amounts to bad faith. It would be unconscionable to require defendants to bear the burden of their defense cost." *Maurice A. Garbell, Inc. v. Boeing Company*, 385 F.Supp. 1, 38 (D.C. Cal. 1973).

As this Court declared:

"Any willful act concerning the cause of action which rightfully can be said to transgress equitable standards of conduct is sufficient cause for the invocation of the maxim by the chancellor." *Precision Instrument Manufacturing Co. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806, 815, 65 S.Ct. 993 (1945).

The Eighth Circuit authority relied upon by the Garbell patentees (Pet., pp. 3, 10, 11, 16) is not in conflict with these basic premises. As must be obvious to all, the Garbell patentees' conduct has been "willful" throughout. *Pfizer, Inc. v. International Rectifier Corp.*, 538 F.2d 180 (8th Cir. 1976).

The trial court in the present actions noted Dr. Garbell's testimony before District Court Judge Yankwich in obtaining the earlier CVAC decree when "shop rights" was an issue:

"*THE COURT*: The question is whether it was fraud or gross negligence on the Patent Office, not on the court. *The only fraud that I felt that was practiced on the court was that Garbell, down in the Yankwich case testified, (1) namely*

that at Convair he didn't have anything to do with Convair aircraft; whereas, in this court he testified under oath that he did—he had everything to do with it." [R.T. October 1, 1973, pp. 22-23, *Hearing on defendants' motion for attorney fees*].

This conduct alone would be sufficient for finding a case to be "exceptional" within the meaning of 35 U.S.C. §285. *Skil Corporation v. Lucerne Products, Inc.*, 503 F.2d 745 (C.A. Ill. 1974), *cert. denied* 420 U.S. 974, 95 S.Ct. 1398.

Commencing with his misconduct in the Patent Office in 1946, Dr. Garbell has left an unmistakable trail. In 1950, Garbell deliberately misled District Court Judge Yankwich in obtaining the CVAC decree. After filing the present actions in 1963, the Garbell patentees have used the CVAC decree at every opportunity [C.T. 328-386, 654, 1560, 1594, 1913-1915] as a form of *estoppel* against defendants to assert the *obvious invalidity* of the patent in suit and the *bad faith* of the Garbell plaintiffs throughout. The Garbell plaintiffs have used the CVAC decree to move themselves into an advantageous position to which they are not entitled in view of Garbell's testimony in the CVAC action.

To this day, the Garbell petitioners are using the CVAC decree in order to gain an unfair advantage over defendants (*Pet. for Writ of Cert.*, pp. 3, 4, 6, 8, 9, 11, 12, 16). The Garbell petitioners state, in essence, that since the Ninth Circuit Court of Appeals, in reversing the CVAC case, "did not tell the patent holders that they did not possess a valid patent", that they came into these actions in good faith (*Pet.*, p. 11). The Garbell petitioners urge this Court to believe that there had been a full and fair

prior adjudication of the validity of the Garbell patent in suit (in the CVAC action) which *they know to be untrue*.

The Garbell patentees' use of the early CVAC decree in the present actions [C.T. 328-386, 654, 1560, 1594, 1913-1915], obtained by Garbell's suppression from Trial Judge Yankwich in the CVAC action pertinent facts affecting the validity of the '758 parent patent, brings the present actions directly within the rule announced by this Court:

"The actual use made of that decree is sufficient to show that plaintiff did not come with clean hands in respect of any cause of action in these cases." *Keystone Driller Company v. General Company; Keystone Driller Company v. Osgood Company*, 290 U.S. 240, 247 (1933), 54 S.Ct. 146, 78 L.Ed. 293.

The trial court's findings that, "Defendants are not bound by the trial court decision in the CVAC case and are not estopped to assert invalidity of the patent in suit" (*FF M1-M11*, 385 F.Supp. 1, 36-37), and that, "The actions were not filed or maintained in good faith" (*FF N2*, 385 F.Supp. 1, 37), are consistent with the law laid down by this Court.

This Court has declared:

"It is a principle in chancery, that he who asks relief must have acted in good faith. The equitable powers of this court can never be exerted in behalf of one who has acted fraudulently or who by deceit or any unfair means has gained an advantage. To aid a party in such a case would make this court the abetter of iniquity." *Bein v. Heath*, 6 How. 228, 247.

It Would Be Unconscionable to Require Defendants to Bear the Burden of Their Defense Expenditures.

The law is well established that the trial court's discretion in awarding attorney fees in patent cases may be invoked only upon a finding of bad faith or inequitable conduct on the part of the losing party which would make it grossly unjust for the prevailing party to be left with the burden of his litigation expenses. *Purer & Co. v. Aktiebolaget Addo*, 410 F.2d 871 (9th Cir.), *cert. denied* 396 U.S. 834, 90 S.Ct. 90, 24 L.Ed.2d 84 (1969); *Rohr Aircraft Corporation v. Rubber Teck, Inc.*, 266 F.2d 613, 624 (9th Cir. 1959); *Park-In Theaters, Inc. v. Perkins*, 190 F.2d 137, 142 (9th Cir. 1951).

The trial court in these actions found:

"N17. The conduct of plaintiffs as outlined in these findings is wholly unjustified and amounts to bad faith. It would be unconscionable to require defendants to bear the burden of their defense cost." *Maurice A. Garbell, Inc. v. Boeing Company*, 385 F.Supp. 1, 38 (D.C. Cal. 1973).

The findings of Dr. Garbel's bad faith in securing the patent monopoly (1) by suppressing from the Patent Office relevant evidence of prior publications, and (2) signing an oath that the claimed invention had not been described in printed publications (*FF N13-N15, N17*; 385 F.Supp. 1, 38) are an adequate foundation for deciding that these cases are "exceptional" within the meaning of 35 U.S.C. Section 285. *Monolith Portland Midwest Co. v. Kaiser Aluminum and Chemical Corp.*, 407 F.2d 288 (9th Cir. 1969); *Shelco Inc.*

v. Dow Chemical Co., 466 F.2d 613 (7th Cir. 1972); *Kahn v. Dynamics Corp. of America*, 508 F.2d 939 (2nd Cir. 1974), *cert. denied* 421 U.S. 930, 95 S.Ct. 1657, 44 L.Ed.2d 88 (1975).

Plaintiffs Brought These Actions With Full Knowledge of the Obvious Invalidity of the Garbell Patent.

The trial court in these actions found:

"N2. The actions were not filed or maintained in good faith."

* * *

"N11. From the evidence offered by the plaintiffs, without limitation in Exhibits 686 and 695, the plaintiffs knew that [the] patent was invalid and yet continued to pursue the action." *Maurice A Garbell, Inc. v. Boeing Company*, 385 F.Supp. 1, 37-38 (D.C. Cal. 1973).

These actions are "exceptional" since the Garbell plaintiffs brought the actions with full knowledge of the obvious invalidity of the patent in suit. *Tidewater Patent Development v. Kitchen*, 371 F.2d 1004 (4th Cir. 1967), *cert. denied* 389 U.S. 821, 88 S.Ct. 46, 19 L.Ed.2d 74. Bringing an infringement suit to enforce an obviously invalid patent is evidence of bad faith. *Talon v. Union Slide Fastener*, 266 F.2d 731 (9th Cir. 1959); *Shingle Product Patents v. Gleason*, 211 F.2d 437 (9th Cir. 1954).

The Circuit Courts are consistent in holding cases such as these to be "exceptional" within the meaning of 35 U.S.C. §285 where it is found that the misconduct arose in securing the patent and in conducting litigation

after securing the patent. *L. F. Strassheim Co. v. Gold Metal Folding Furniture*, 477 F.2d 818 (7th Cir. 1973); *Penn Yan Boats, Inc. v. Sea Lark Boats*, 359 F.Supp. 948 (D.C. Fla. 1972), *aff'd per curiam* 479 F.2d 1328 (5th Cir. 1973), *cert. denied* 414 U.S. 874, 94 S.Ct. 66, 38 L.Ed.2d 115.

The Garbell plaintiffs had Exhibits 695-1 through 695-71A [C.T. 2703, 2764] in their possession since 1967. By putting those exhibits into evidence, without limitation, the plaintiffs added to the proof that (1) the claims of the patent in suit were anticipated by the Curtiss-Wright Models 21B and 23 aircraft wings; (2) the subject matter of the patent was obvious to one skilled in the art, and "was merely an aggregation of general knowledge and formulae that had been available to designers for many years as well as published by the NACA"; (3) the claims cover devices which were old and unpatentable over the prior art; (4) that the prior art asserted by the defendants in the CVAC case was good prior art in the 1950 trial, and was still good prior art; and (5) that the patent should have been adjudicated invalid and anticipated by the Curtiss-Wright Models 21B and 23 aircraft wings in the CVAC action. Notwithstanding, the Garbell plaintiffs pressed on, causing the defendants the litigation expense in proving what the Garbell plaintiffs knew beyond any doubt—that the patent was obviously invalid. The trial court found that:

"N8. The plaintiffs denied requests for admissions directed to the airfoil section parameters, including mean-line camber of the prior art Curtiss-Wright Models 21B and 23 aircraft. Issues as to the shape of such wings were tried by the Special Master and the Special Master made his

findings with respect to such parameters. Plaintiffs objected to such findings before the Court trial; then at the trial, plaintiffs introduced documentary evidence which substantiated fully the Special Master's findings as to the wing geometry of those aircraft, and also proved that the Models 21B and 23 wings showed aerodynamic improvements over previous Curtiss-Wright models. That the Curtiss-Wright Models 21B and 23 aircraft invalidate Claims 1, 2, 3 and 7 of the patent in suit appears elsewhere in these findings and in the Conclusions of Law."

* * *

"N9. Plaintiffs put in evidence opinions that the patent in suit was anticipated."

* * *

"N10. Plaintiffs put in evidence that a description of a wing design covered by the patent was circulated in the NACA, a public body, before the earliest date the patentee can claim as a reduction to practice, i.e. the filing date of the patent application." *Maurice A. Garbell, Inc. v. Boeing Company*, 385 F.Supp. 1, 37-38 (D.C. Cal. 1973).

In applying 35 U.S.C. §285, Judge Stevens stated:

"The award in this case is supported not only by the patentee's failure to verify or disclose critical facts at the time of application, but also by the same considerations that underlie the authorization of sanctions for failure to make discovery. See Rule 37, Fed.R.Civ.P." *L. F. Strassheim Co. v. Gold Metal Folding Furniture Co.*, 477 F.2d 818, 824 (7th Cir. 1973).

The Garbell Plaintiffs Did Not Make a Reasonable Assessment of the Possibilities of Infringement Before Bringing Suit, or to Date.

In 1964, again under oath in deposition, Garbell testified that prior to filing these actions, he had never compared the claims of his patent to the accused aircraft wings [*Ex. HT*, p. 124; *R.T.* 774, 826, 1083]. In 1971, eight years later, they had made no effort to assess their infringement allegations in the Boeing action [*R.T.* 858-859, 879-880], and they refused to assess their infringement allegations against Douglas [*Maurice A. Garbell, Inc. v. Boeing Co.*, 385 F.Supp. 1, 2-9, 37-38; *C.T.* 3485 *et seq.*].

The Garbell plaintiffs cannot now rely on the DC-8 wing for any purpose. There was no trial on the infringement issue in the District Court—plaintiffs saw to that [*C.T.* 3485 *et seq.*; *Maurice A. Garbell, Inc. v. Boeing Co.*, 385 F.Supp. 1, 3-5, 56-57]. The Garbell plaintiffs claimed they were “surprised by their own evidence” presented to the Special Master and contained in the Supplemental Report [*C.T.* 2634 *et seq.*, 2708, 2733, 2741, 2778, 2801, 2833, 2929, 2934; See *Second Supplemental Report of the Special Master and Recommendation that the Order of Remand to the Special Master be Rescinded*, at *C.T.* 3485 *et seq.*]. The geometry findings on the DC-8 wing, contained in the Supplemental Report of the Special Master [*C.T.* 2634 *et seq.*] prove there is no infringement, and plaintiffs refused to prepare for or attend a hearing on the remand sought by them and granted by the Court [*C.T.* 3485 *et seq.*].

From the evidence, outlined herein, the trial court found:

“N16. The plaintiffs had no meaningful evidence upon which to base their allegations of infringement prior to filing the complaints in these actions. They opposed Boeing’s request for an early trial on the Boeing infringement issue. Plaintiffs refused to go to trial on the remand to the Special Master for additional findings on the Douglas infringement issue, after they discovered his initial findings were unfavorable to them. Plaintiffs presented evidence in this trial which they have had in their possession since 1967, and which would support a finding that the patent was invalid.” (*Maurice A. Garbell, Inc. v. Boeing Company*, 385 F.Supp. 1, 38).

The trial court additionally found that (1) the plaintiffs failed to use reasonable care in assessing their allegations of infringement against Boeing; (2) plaintiffs had not sought to go to trial on the issue of infringement in the Boeing case throughout the lengthy history of the case; (3) plaintiffs moved for summary judgment of willful infringement against Douglas with respect to the DC-9 aircraft wing, and a few months later dropped any claim based on the DC-9 wing; (4) plaintiffs’ failure to furnish evidence supporting their infringement allegations against Douglas with respect to the DC-8 airplane wings, though repeatedly requested by the Special Master to do so, was irresponsible and inexcusable; and (5):

“N12. Plaintiffs have used the patent in an attempt to exact undue tribute from the two defendants.” (*Maurice A. Garbell, Inc. v. Boeing Company*, 385 F.Supp. 1, 37-38; FF N3, N4, N5, N6, N7, N12).

The Circuit Courts are consistent in holding cases such as these to be "exceptional" within the meaning of 35 U.S.C. §285 where the allegation of infringement is frivolous and/or asserted without reasonable care and sufficient justification. *Talon, Inc. v. Union Slide Fastener, Inc.*, 266 F.2d 731 (9th Cir. 1959); *Kaehni v. Diffraction Co., Inc.*, 342 F.Supp. 523 (D.C. Md. 1972), *aff'd*, 473 F.2d 908 (4th Cir. 1973), *cert. denied* 414 U.S. 854, *rehearing denied* 414 U.S. 1033.

"[I]f obvious invalidity can serve as an indication of bad faith, the obvious absence of infringement should serve even more forcefully to indicate bad faith." *Kaehni v. Diffraction Co., Inc.*, 342 F. Supp. 523, 536, *aff'd per curiam* 473 F.2d 908 (4th Cir. 1973), *cert. denied* 414 U.S. 854, *rehearing denied* 414 U.S. 1033.

The Garbell Plaintiffs Unduly Prolonged These Actions Far Beyond Any Concept of a Civil Case in Any Court, Let Alone a Federal Court.

The trial court, in its tentative decision on June 2, 1972 [*R.T. June 2, 1972, pp. 181-210*], stated that the Garbell plaintiffs "improvidently brought" these actions, that the "plaintiffs unduly and deliberately fought against going to trial, although they were plaintiffs", and that the Garbell plaintiffs "unduly prolonged these actions far beyond any concept of a civil case in any court, let alone a Federal Court". [*R.T. 6/2/72, p. 209*]. The trial court specifically found:

"N1. The plaintiffs before-trial proceedings in this action make this case one that is extraordinary."

"N2. The actions were not filed or maintained in good faith."

"N12. Plaintiffs have used the patent in an attempt to exact undue tribute from the two defendants." (*Maurice A. Garbell, Inc. v. Boeing Company*, 385 F.Supp. 1, 37-38).

The trial court's Preliminary Findings and Memorandum Decision (*Maurice A. Garbell, Inc. v. Boeing Company*, 385 F.Supp. 1, 2-9), reveal the frustrations experienced by the Special Master, the trial court, and the defendants in trying to move these cases to a final determination in trial before the District Court.

"Plaintiffs proceeded on the barest minimum of allegations sufficient to keep factual issues alive and avoid the numerous motions . . . The eccentricities of federal pleading generally, and patent law particularly, permitted this case to survive . . . years of discovery and proceed to trial." *Kaehni v. Diffraction Company*, 342 F.Supp. 523, 532 (D.C. Md. 1972), *aff'd per curiam* 473 F.2d 908 (4th Cir. 1973), *cert. denied* 414 U.S. 854, *rehearing denied* 414 U.S. 1033.

"The Federal Rules of Civil Procedure permit minimal pleadings, and a complaint will survive motions to dismiss and summary judgment so long as the plaintiff has salvaged a single 'genuine issue as to any material fact'. In patent cases the issue of infringement is not such as can be ferreted out as frivolous without going into a detailed investigation which would tend to defeat the purposes of the federal rules. The parties must be trusted to act responsibly. See Fed.R.Civ. P. 11." *Kaehni v. Diffraction Company*, 342 F.Supp. 523, 536, *aff'd per curiam* 473 F.2d 908 (4th Cir. 1973), *cert. denied* 414 U.S. 854, *rehearing denied* 414 U.S. 1033.

The Circuit Courts are consistent in holding that: "[W]here a case is 'exceptional' for proper reasons, prolongation of the case even if resulting from counsel's conduct, is properly considered in determining the amount of fees to be awarded." *Kaehni v. Diffraction Company*, 342 F.Supp. 523, 537 (D.C. Md. 1972); 473 F.2d 908 (4th Cir. 1973), cert. denied 414 U.S. 854, rehearing denied 414 U.S. 1033. See also *Monolith Portland Midwest Co. v. Kaiser Aluminum & Chemical Corp.*, 407 F.2d 288 (9th Cir. 1969).

The trial court expressly found that, "The conduct of plaintiffs as outlined in these findings is wholly unjustified and amounts to bad faith" and, "Such conduct warrants an award of reasonable attorneys fees which are fixed in the amount of \$237,062.50, the Court finding that counsel for defendants have reasonably expended 18,525 hours in the legal work and litigation necessarily incurred and performed in the proper and adequate defense of this action". (*Maurice A. Garbell, Inc. v. Boeing Company*, 385 F.Supp. 1, 38; FF N17 & N18). In affirming the Ninth Circuit Court of Appeals stated:

"The trial court's findings of bad faith are supported by the record and are not clearly erroneous. We agree with the trial court that this is an 'exceptional' case which justifies the award of attorney's fees under 35 U.S.C. §285.

"The award of \$237,062.50 in attorney's fees is one of the largest reported awards under 35 U.S.C. §285. However, in light of the extraordinary length of time (ten years) that was consumed by these proceedings and the necessarily great number

of hours expended on behalf of the defendants by their counsel,¹⁰ we cannot say that this award is excessive or unreasonable." *Maurice A. Garbell, Inc. v. Boeing Co.*, 546 F.2d 297, 300-301 (9th Cir. 1976).

In the Garbell plaintiffs' Motion to Alter or Amend the Judgment [C.T. 3732, 3742], plaintiffs were willing to accept the judgment of invalidity of the '758 patent and the judgment of attorney's fees in a reduced amount of \$2,500; at the same time representing to the trial court, in an Affidavit, that the total assets of each plaintiff corporation were Four dollars (\$4.00) [C.T. 3742-3745]. The Garbell petitioners' suggestion (*Pet.*, pp. 2, 10, 16) that the award of attorney's fees pursuant to 35 U.S.C. §285 punishes them is not well taken. The trial court found:

"N17. The conduct of plaintiffs as outlined in these findings is wholly unjustified and amounts to bad faith. *It would be unconscionable to require defendants to bear the burden of their defense cost.*" *Maurice A. Garbell, Inc. v. Boeing Co.*, 385 F.Supp. 1, 38.

The purpose for the award under §285 is to "reasonably" compensate defendants for their efforts in succeeding in invalidating the obviously invalid Garbell '758 patent. If the Garbell plaintiffs want to litigate (CVAC action) and relitigate (the present actions) an obviously invalid patent, then they alone should bear the litigation expenses when they do not prevail.

¹⁰These proceedings began in 1963 and took over ten years to complete, even excluding the time consumed by this appeal. The court found that counsel for the defendants reasonably expended 18,525 hours on this case."

Section 285 of 35 U.S.C. needs no restatement by this Court. The courts below *know* an "exceptional" case when they see one. In finding the present actions to be "exceptional", the courts below followed well established principles laid down by this Court.

Many Bases Exist Under Each Code Section for Finding the Garbell Patent Invalid.

The district court held that the '758 parent patent in suit did not meet the test of novelty and utility as required by 35 U.S.C. Section 101; it was anticipated by prior art and thus was invalid under 35 U.S.C. Section 102(a); the invention had been on sale and in public use more than one year prior to the date of the application for the patent as contemplated by 35 U.S.C. Section 102(b); the subject matter of the patent was obvious to one skilled in the art and thus the patent was invalid under 35 U.S.C. Section 103; and the teachings of the patent were insufficient and the claims ambiguous under 35 U.S.C. Section 112.

Unequivocal, Clear and Convincing Evidence Was Presented to the Trial Court. The Evidence Fully Supports the District Court's Findings of Fact. The Correct Law Was Properly Applied to the Findings of Fact. The District Court's Findings of Fact and Conclusions of Law Fully Support Its Judgment.

Unequivocal, clear and convincing evidence was presented to the trial court. The evidence fully supports the district court's findings of fact. The correct law was properly applied to the findings of fact. The district court's findings of fact and conclusions of law fully support its judgment. In affirming the trial court, the Ninth Circuit Court of Appeals stated:

"In reaching its findings, the court relied upon evidence produced in lengthy proceedings which included the testimony of several expert witnesses and the interpretation of numerous scientific exhibits. Unless found to be clearly erroneous, the findings of the district court must be upheld. Fed. R.Civ.P. 52(a); *Tri-Tron International v. A.A. Velto*, 525 F.2d 432 (9th Cir. 1975); *W. S. Shamban and Co. v. Commerce and Industry Insurance Co.*, 475 F.2d 34 (9th Cir. 1973)." *Maurice A. Garbell, Inc. v. Boeing Co.*, 546 F.2d 297, 299.

The Ninth Circuit Court of Appeals specifically stated that they had reviewed the evidence which had taken the parties one year to designate, assemble and supplement for that court's review:

"After a review of the record in this case, we cannot say that these findings are clearly erroneous. Since the district court applied the correct law to the findings, we must affirm the judgment as to the invalidity of this patent." *Maurice A. Garbell, Inc. v. Boeing Co.*, 546 F.2d 297, 299 (1976).

The district court announced its tentative decision in detail from the bench [*R.T. June 2, 1972, C.T. 3484*], post-trial summary of facts were supplied [*C.T. 3387 et seq.*], proposed findings were submitted to the court, objections to the proposed findings were filed by plaintiffs, record support for the findings was supplied to the court [*C.T. 3528-3554*]. Thereafter, the trial court modified the proposed findings of fact and conclusions of law, and made its own preliminary findings and memorandum decision (*Maurice A. Gar-*

bell, Inc. v. Boeing Company, 385 F.Supp. 1, 2-57). The findings meet all of the requirements of *United States v. El Paso Natural Gas Co.*, 376 U.S. 651, 84 S.Ct. 1044.

Many bases exist under each code section for finding the patent invalid (*Maurice A. Garbell, Inc. v. Boeing Company*, 385 F.Supp. 1, 2-39). The law laid down by this Court under each code section was properly applied here and there is no conflict among the Circuit Courts of Appeals, all of which is apparent from the case citations appearing in the Conclusions of Law (385 F.Supp. 1, 39-44).

The Garbell Patent in Suit Did Not Meet the Test of Novelty and Utility as Required by 35 U.S.C. §101.

Title 35 United States Code §101 states:

“§101 *Inventions Patentable.* Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. July 19, 1952, c. 950, § 1, 66 Stat. 797.”

The Garbell patent in suit and its claims do not meet the test of novelty and utility within the meaning of 35 U.S.C. §101 and are therefore invalid.

The Garbell '758 patent in suit never enjoyed any commercial success during its life; it died of old age in the Federal Courthouse on May 18, 1965, twelve years ago. No one paid to license the '758 patent; in fact, every airframe manufacturer in the United States and Great Britain that was approached, told the Garbell plaintiffs that the subject matter was old

and unpatentable [C.T. 788-791.] Twelve years ago when the '758 patent had but a mere three months to run before expiring, the Garbell plaintiffs, in a final burst of generosity, gave a royalty-free license to the government [R.T. 3567]. There is no evidence that the government or anyone ever constructed a wing by following the '758 patent.

The primary policy of the patent laws is to promote invention for the benefit of the public. Private gain is secondary.

Pennock v. Dialogue, 2 Pet. 1, 7 L.Ed. 327 (1829);

Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U.S. 502, 510-511, 37 S.Ct. 416, 61 L.Ed. 871 (1917);

Mercoird Corp. v. Mid-Continent Inv. Co., 320 U.S. 661, 665, 64 S.Ct. 268, 88 L.Ed. 376 (1944);

Mazer v. Stein, 347 U.S. 201, 219, 74 S.Ct. 460, 98 L.Ed. 630 (1954);

Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 330-331, 65 S.Ct. 1143, 89 L.Ed. 1644 (1945).

A valid patent must add to, not detract from, the state of the prior art. It is a public service to strike down an invalid patent, which is in truth a trespass upon the public domain, as Justice Douglas observed in *Automatic Radio Mfg. Co. v. Hazeltine Research*, 339 U.S. 827, 840, 70 S.Ct. 894, 94 L.Ed. 1312 (1950).

The very power of Congress to grant a patent is limited and delineated by the purpose proclaimed in the constitutional grant itself:

"The Congress shall have Power To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." *Constitution of the United States*, Article I, Section 8, Clause 8.

The power is one "To promote the Progress of Science and useful Arts"; the "exclusive Right" conferred by the patent is merely the means of accomplishing the intended result. *Automatic Radio Mfg. Co. v. Hazeltine Research*, 339 U.S. 827, 836-837; *Great A. & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 154-156, 71 S.Ct. 127, 95 L.Ed. 162 (1950); U.S. Const. Art. I, sec. 8, cl. 8.

The Garbell '758 patent teachings were old, not new, in 1945, and the claimed combinations achieved no unexpected result.

Claims 2, 3 and 7 of the '758 patent rely on a method which Ira Abbott, formerly Director of Research for NASA, stated to the Trial Court was old and that "some of the English maintain that this was done to some extent in England even before the turn of the century." "The first attempt to do this, in anything like a useful manner was by Prandtl in the general period around the beginning of World War I." "I think his work covers the period of about six years more or less centered around 1914." [Abbott: R.T. 1360-1361].

The aerodynamic principle, utilized by Garbell in the claims of his '758 patent alleged to be infringed, is that increasing the camber of a given airfoil section, in general, raises the maximum lifting capability of the wing in which that section is placed. Dr. Munk,

plaintiffs' own witness, testified that an increase in camber to delay the occurrence of stall in a wing "is the broad rule and generally to be expected with great probability". Further, Dr. Munk testified that he had been aware of this rule "since 1915". [Deposition read by court *Munk*: (Deposition p. 90, line 12 thru 92, line 13). R.T. 2132 and [*Munk* Deposition: Exhibit IE, p. 92, R.T. 2110, 2185].

The National Advisory Committee for Aeronautics ("NACA") was created by the Congress in 1915 "for the supervision and direction of the scientific study of the problems of flight". 15 U.S.C. §151.

In 1929 the NACA undertook systematic study of airfoil sections so that wing designers would have available to them data on airfoil sections for use in the aircraft wings. The initial results of this work were published in 1933 by the NACA in Report No. 460 entitled "The Characteristics of 78 Related Airfoil Sections from Tests in the Variable Density Wind Tunnel", *Exhibit A*, co-authored by Robert M. Pinkerton, one of the witnesses for the defendants in this action [Ex. A, R.T. 967].

It is to be noted that copies of NACA reports, such as No. 460, Ex. A [R.T. 967], were priced at 15 cents.

Concurrently, the NACA was studying the performance of wings which incorporated the airfoil sections it had developed and analyzed. Report No. 572, *Exhibit E* [R.T. 1331] is entitled "Determination of the Characteristics of Tapered Wings" from which "the characteristics of a wing of any form may be calculated when the section characteristics are known from experiment" and includes "a method for estimating the lift

coefficient at which a tapered wing begins to stall". [Exhibit E, p. 1 R.T. 1331] Report No. 703, *Exhibit I* [R.T. 988] is entitled "Design Charts Relating to the Stalling of Tapered Wings", and Technical Note No. 713 presented "A Comparison of Several Tapered Wings Designed to Avoid Tip Stalling". Report No. 627, entitled "Experimental and Calculated Characteristics of 22 Tapered Wings", *Exhibit G* [R.T. 1079] at page 14, suggests that in a wing designed to avoid tip stalling, airfoil "sections having increasing c_l max. (increased camber) toward the tips" be used.

When Professor Pinkerton, who was with NACA when these reports were prepared, was asked to compare the prior art with the patent in suit, he simply stated "I can't read anything in the patent beyond what we knew and practiced in the '30's." [R.T. 1021.]

Ira Abbott, who co-authored NACA Report No. 824, *Ex. K*, R.T. 1342, 1343 entitled "Summary of Airfoil Data" which was later published in book form under the name "Theory of Airfoil Sections", *Ex. 36-1* [R.T. 1519] testified:

"If there is anything new in the patent, I have been unable to find it." [R.T. 1427.]

At trial Garbell finally conceded that the novelty he had theretofore claimed was in fact old in the art.

He conceded it was old in the art:

- (1) to use three or more controlled sections to define the exterior shape of an aircraft wing;
- (2) to select such sections for aerodynamic purposes including avoiding tip stall—an object of the patent;

- (3) to increase the lift of a section to avoid tip stall by increasing the camber of the section;
- (4) to have the least cambered section at the root,
- (5) the greatest cambered section at the tip; and
- (6) an interjacent section that was at variance with the section obtainable by straight line fairing between root and tip. [R.T. 120-121, 204-205, 167, 791, 792, 796, 890, *Ex. G, I*, R.T. 1079-988].

This Court has admonished:

"Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men." *Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 152-153, 71 S.Ct. 127, 95 L.Ed. 162 (1950). See also *Lincoln Engineering Co. of Illinois v. Stewart-Warner Corp.*, 303 U.S. 545, 58 S.Ct. 662, 82 L.Ed. 1008 (1938).

The Garbell '758 patent claims a grouping of old elements (airfoil sections), functioning in the same manner (in a wing), which produce no new or syner-

gistic result. As demonstrated herein at pages 10-14, the prior art Pinguino sailplane wing achieved the same result; *i.e.* the result which Garbell likes to call the "Garbell Stall".

In *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 151, 152, 71 S.Ct. 127, 95 L.Ed. 162, this Court said that the concept of invention is inherently elusive when applied to a combination of old elements. This Court pointed out that the conjunction of known elements must contribute something, and that only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. In *A. & P.* this Court also noted that it is more likely that a valid combination could be found in chemistry or electronics than in mechanics. This Court said:

"Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics." *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. at 152, 71 S.Ct. at 130.

In affirming the trial court in these actions, the Ninth Circuit Court of Appeals stated:

"The court also found that the essence of the Garbell Wing had been published and was well known more than one year prior to his patent application. This knowledge was imparted through reports and publications by Garbell himself as well as by other aeronautical engineers and the National Committee on Aeronautics." *Maurice A. Garbell v. Boeing Co.*, 546 F.2d 297, 299 (9th Cir. 1976).

The trial court's findings are fully supported by the evidence. In addition to the evidence presented by the Garbell plaintiffs, without limitation, in Exhibits 695-1 through 695-71A [C.T. 2703, 2764] as summarized herein on p. 50, the subject matter of Garbell's patent was more completely disclosed in the following publications than in the patent: (1) Zien article published in *Luftfahrtforschung*, Germany 1938 [Exs. AP, AP-1; R.T. 442, 490]; (2) Dr. Albert E. Lombard, Jr.'s disclosure (1936), *Journal of the Aeronautical Sciences* [Exs. BC; R.T. 984]; (3) Lachmann's disclosure (1937) *Journal of the Royal Aeronautical Society* [Exs. AO, AO-1; R.T. 437]; and the NACA publications. The object of Garbell's alleged invention and Garbell's approach to wing design was old in 1945. Every witness, including Garbell, testified that the subject matter of the Garbell patent was old. Not one witness was produced by the Garbell plaintiffs to testify that there was any novelty at all in the patent in suit. In summary:

*Dr. Lombard stated that the methodology set forth in the patent in suit was, "Widely known" by 1944; and further, "My opinion, sir, is that it should have been known. That methodology was published in the three most reputable professional journals . . .". [Lombard: R.T. 1733.]

*Dr. Lombard testified that Zien's disclosure for providing high lift and low drag is a more complete disclosure than the description of the alleged invention set forth in the specification of the '758 patent. [R.T. 1688-1690.]

*"I can't read anything in the patent beyond what we knew and practiced in the 30s". [Pinker-ton: R.T. 1021.]

*Mr. Ira Abbott testified, "If there is anything new in the patent, I have been unable to find it". [*Abbott*: R.T. 1427.]

*In an Italian article published in 1938, Mr. G. Preti, a sixteen year old colleague of Garbell, wrote of the advantages of combining more than two airfoil sections in a wing. In Exhibit AI, Mr. Preti states: "All airplane designers know the advantages which are obtained by the use of wings, the profile of which is not constant, but varies from root to tip." [Exhibit AI, R.T. 535, 539].

The only live witness, other than Dr. Garbell, produced by plaintiffs at trial was Dr. William Bailey Oswald, formerly chief aerodynamicist at Douglas when the DC-8 airplane was designed. Dr. Oswald testified that he had never even read the Garbell patent in suit [R.T. 2897-2898]. When he was shown the patent drawings at trial, Dr. Oswald testified that the patent drawing (Fig. 2) demonstrated a dangerous stall characteristic [R.T. 2906].

To the extent that the validity of the claims of the patent in suit depends on a combination of elements that produce in some way or manner a surprising or unusual result which would not have been expected by a person having ordinary skill in the art, the patent in suit does not meet this test.

Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 71 S.Ct. 127, 95 L.Ed. 162 (1950);

Anderson's Black Rock, Inc. v. Pavement Salvage Co., Inc., 396 U.S. 57, 90 S.Ct. 305, 24 L.Ed.2d (1969);

Spring Crest Company v. American Beauti Pleat, Inc., 420 F.2d 950 (9th Cir. 1970);

Hamlow v. Scientific Glass Apparatus Corp., 421 F.2d 173 (9th Cir. 1970).

Wings covered by the patent claims do not produce uniform results. The Curtiss prior art aircraft achieved the objects of the patent (see prior section on Curtiss, pp. 28-31 herein), the Convair 240 [CVAC Tr. 372, 373; RM 1-2; R.T. 833, 834] had root stall and the Convair 880 had tip stall [R.T. 1651-9].

The '758 patent drawings themselves demonstrate a dangerous stall [*Oswald* R.T. 2906]. As Mr. Dunn of McDonnell Douglas observed with respect to Fig. 2 "In the vernacular that is a lousy wing." [R.T. 3619-20].

Dr. Lombard testified that the prior art, however, had solved the stall problem by 1940.

"Lachmann visited Cal Tech during the period of approximately 1937 to 1940 at a time when I was in residence at Cal Tech and we had an opportunity to discuss our researches not only in dealing with the subject of camber but in dealing with the broader subject of lift and stall characteristics.

"The details of that discussion escapes my memory, but I have a strong recollection that we had substantial agreement and harmony between the two of us that 'A' this was the problem and that there was a variety of solutions to this problem." [R.T. 1718, 1719].

Where the prior art wings achieve the results sought by the inventor with an assemblage of old elements

and later designs covered by the claims do not, the court correctly found the patented combinations achieve no new result, Findings H1-H17, and lack utility.

In *Graver Tank & Mfg. Co. v. Linde Air Products*, 336 U.S. 271, 276-277 (1949), the Supreme Court stated that claims which are drawn so broadly as to read upon significant numbers of inoperative embodiments are invalid.

"Utility *vel non* presents a question of fact. As well said by Judge Learned Hand, 'A judge is entirely unadapted to decide such a question as an original question and must rely upon the testimony of skilled artisans or of experts in mechanics.' *Manhattan Book Casing Mach. Co. v. E. C. Fuller Co.*, S.D.N.Y. 1912, 274 F. 964, 967."

Lorenz v. General Steel Products Company, 337 F.2d 726, 727 (5th Cir. 1964).

The term "useful" as used in the patent law means that the invention must attain the result claimed by the inventor in his disclosure; in other words, it must work and accomplish the purposes set forth in the specifications. *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 119, 14 L.Ed. 601 (1853); *Coupe v. Royer*, 115 U.S. 565, 572-574, 579, 15 S.Ct. 199, 39 L.Ed. 263 (1895); *H. Brinton Co. v. Mishcon*, 93 F.2d 445, 448 (2d Cir. 1937); *Moffett v. Fiske*, 51 F.2d 868, 871-872 (D.C. Cir. 1931); *Besser v. Merrilat Culvert Core Co.*, 243 F. 611, 612 (8th Cir. 1917).

In *O'Reilly v. Morse*, *supra*, 56 U.S. at 119, the Supreme Court spoke directly to the point in issue:

"Whoever discovers that a certain useful result will be produced, in any art, machine, manufacture, or composition of matter, by the use of certain means, is entitled to a patent for it; provided he specifies the means he uses in a manner so full and exact, that any one skilled in the science to which it appertains, can, by using the means he specifies, without any addition to, or subtraction from them, produce precisely the result he describes. And if this cannot be done by the means he describes, the patent is void."

The Garbell Patent in Suit Was Anticipated by Prior Art and Thus Was Invalid Under 35 U.S.C. §102(a). Garbell's Alleged Invention Had Been on Sale and in Public Use and Described in Printed Publications More Than One Year Prior to the Date Garbell Filed His Patent Application. Thus, the Garbell Patent Was Invalid Under 35 U.S.C. §102(b).

The Garbell patent in suit was anticipated by the prior art Curtiss-Wright Model 21B and Model 23 airplane wings [FF1-FF23; 385 F.Supp. 1, 18-21].

The geometry findings of the Special Master on the Curtiss-Wright Model 23 and Model 21-B prior art wings are set forth and discussed in some 20 pages of the Original Report of the Special Master [Court Exhibit 1; C.T. 2308-2327]. The Curtiss-Wright Models 23 and 21-B have identical wing geometry [C.T. 2309]. From the Special Master's geometry findings on these Curtiss-Wright prior art wings, and from the additional evidence presented at the trial before the District Court, the Trial Court found the '758 patent to be invalid and anticipated by the Curtiss-

Wright Models 23 and 21-B prior art wings [Findings of Fact F1 through F22 at 385 F.Supp. 1, 18 to 21].

The Model 21-B was built and sold in this country in 1940 [R.T. 848-849; 1253; 1258], saw service with the Dutch East Indies Air Force against the Japanese.

Prof. Pinkerton testified, that the wings had all the elements of claims 2, 3 and 7 of the '758 patent [Court Exhibit 1; Exhibit BC; Exhibit F (NACA Report Tr. 586); Exhibits 10, 10-1, IP, IP-1; R.T. 976-987]. The plaintiffs presented no evidence to the contrary.

As set forth herein, pp. 28-32, 50-51, plaintiffs added to the proof that the Curtiss-Wright Model 21B and Model 23 aircraft wings anticipate the Garbell patent in suit. Plaintiffs knew for certain that the patent was anticipated, but still pressed on to trial.

Additional evidence on the aerodynamic characteristics of the CW-21B and CW-23 airplane wings was presented by defendants.

As to the stall characteristics experienced during flight, tests of the Model 23 airplane, Mr. Butterworth testified:

"The stall characteristics were, say, typical and *expected*. There was a pronounced pitch-down of the nose at the stall. There was noticeable buffeting and there would be some roll, sometimes to the left, sometimes to the right. But in each case it was controllable by the pilot without any particular difficulty." [R.T. 1241-1245].

The word "expected" in Butterworth's testimony emphasizes the fact that Butterworth was looking for

good stalling characteristics and he appreciated the fact that the CW-23 airplane demonstrated those qualities in good stall warning and good control of the airplane by the pilot.

The good stalling characteristics of the CW-23 were additionally demonstrated in the Curtiss-Wright Model 21-B. William Nickey, Curtiss test pilot, flew the 21-B and verified that fact [R.T. 1910, 1987].

Beyond any doubt at all, the Curtiss-Wright Model 21B and Model 23 aircraft wings anticipate the claims of the Garbell patent in suit and the aerodynamic stall characteristics of those prior art wings were expected, achieved and recognized by all. There is no evidence to the contrary.

In addition to the Curtiss-Wright anticipation, the trial court found that the "Garbell Wing" was on sale more than one year prior to the date of the patent application and that Garbell actively participated in those sales efforts. *Maurice A. Garbell, Inc. v. Boeing Company*, 385 F.Supp. 1, 8-9, 28-29. As set forth herein, pp. 19-25, the XB-46 airplane wing was on sale and sold prior to the critical date, i.e. July 16, 1945. Contrary to Garbell's testimony in the CVAC action in 1950, Garbell knew that the XB-46 airplane had a 3-section wing which he patented more than one year after it was sold. The sale of the XB-46 data and wind tunnel wing must have been considered by Garbell to be important to the validity of his patent when he testified before Judge Yankwich in the 1950 CVAC action as follows:

"Q. They never told you they were going to use your 3-section wing on that XB-46?

"A. (Dr. Garbell) No." [CVAC R. Tr. 459, Exs. RM-1, RM-2, R.T. 833, 834].

In addition to the sale of the XB-46 airplane wing, Garbell was directly involved in selling "Garbell Wings" in May of 1944, more than two years before he patented those wings. (See pp. 22-24 herein). Contrary to Garbell's testimony before Judge Yankwich in 1950, Garbell's 3-section "tailless" wing was on sale, disclosed to the NACA, a public body, and used by the NACA in 1943-1944. His sales activities must have been deemed by Garbell to affect the validity of his patent when he testified in 1950 before Judge Yankwich that he did not try to sell a tailless airplane to the Navy which incorporated a 3-section wing, and when he testified that the NACA at Langley Field tested only a 2-section wing (See pp. 22-24 herein).

In *Piet v. United States*, 176 F.Supp. 576 (D.C. Cal. 1959), 283 F.2d 693 (9th Cir. 1960), District Court Judge Yankwich, the trier of fact in the earlier CVAC action, found a classified secret sale to be "on sale".

The Ninth Circuit in the case of *Robbins Company v. Lawrence Manufacturing Company*, 482 F.2d 426 (9th Cir. 1973) analyzed the on-sale doctrine:

"A sale or offering for sale precludes any inquiry into the experimental nature of the sale *unless the contract of sale or the offering for sale contains an express or clearly implied condition that the sale or offering is made primarily for experimental use.*"

There is no evidence of a contractual agreement to limit the sale or offering of the CVAC XB-46 wind tunnel wing to Garbell's experimental use. Nor is there the slightest evidence to show that the Government agreed to "experiment" for the benefit of Dr. Garbell.

To the contrary, the contract executed in January 1945 states:

"The contractor hereby grants to the Government the right to reproduce, use and disclose for all governmental purposes any and all reports, drawings, blueprints and data to be delivered by the contractor to the Government under the terms of that contract." [*Exhibit GT; GT-1, R.T. 766, 939*].

No seller-imposed conditions of secrecy are found in the CVAC/Government agreements. Under the rule expressed by this Court in *Robbins*, the absence of any seller-imposed restriction should preclude further inquiry on the subject of "experimental use".

Airplane wings are not shelf items. In fact, plaintiffs themselves averred:

"Sales contracts for aircraft do not await the manufacture of wing models. They are not 'off the shelf' articles". [Plaintiffs' "Motion for Summary Judgment etc.", (C.T. 1089).]

Contrary to the suggestion by the Garbell patentees (Pet. pp. 4, 5, 8, 9, 13, 14), recent authorities are consistent with the public use and on sale holding by this Court in *Egbert v. Lippmann*, 104 U.S. 333, 26 L.Ed. 755; *Elizabeth v. Pavement*, 97 U.S. 126 (1877). See *Robbins Company v. Lawrence Manufacturing Company*, 482 F.2d 426 (9th Cir. 1973); *Dart Industries, Inc. v. E. I. DuPont de Nemours and Co.*, 489 F.2d 1359 (7th Cir. 1973).

As stated by Judge Stevens:

"The record before us discloses completed sales before the critical date as well as other selling activity. In our opinion, the patented product need

not be on hand in commercial quantities for it to be 'on sale' within the meaning of §102(b)."

Dart Industries, Inc. v. E. I. DuPont de Nemours and Co., 489 F.2d 1359, 1365.

Contrary to the Garbell Petitioners' statement (Pet., p. 16), the "Garbell Wing" was described in a printed publication. Dr. Garbell knew that the Pinguino sailplane, which demonstrated convincingly that each of the objects of his "Garbell Wing" invention (later patented) had been fully achieved, had been fully described in printed publications in Europe during the late '30s. See pages 5-16 herein. In addition, Garbell's "official disclosure of invention" to CVAC, was sent to the Institute of Aeronautical Sciences ("IAS") for publication. He testified [R.T. 778-781] that a great many college professors and aerodynamic engineers working in the airframe industry read it before July 15, 1945 [FF I18-I25, 385 F.Supp. 1, 29-30; *Preliminary Findings*, 385 F.Supp. 1, 8-9]. Garbell was told by the IAS that they intended to distribute copies of the "official disclosure of invention" to company libraries and government departments where they would be available for reference [FF I22, 385 F.Supp. 1, 29-30]. As heretofore pointed out (p. 25 herein) the "Poor-Man's Garbell Wing" covered by Claim 11 of the patent in suit, was described in a printed publication [Ex. KF; R.T. 1384, 1396], was released and available to government contractors in March 1945 [FF I16-I17, 385 F.Supp. 1, 29].

Garbell's argument (Pet., p. 16) is not well taken. The "Garbell Wing", the "Poor-Man's Garbell Wing" and the "Official Garbell Wing" were described in printed publications more than one year prior to his patent application.

Hamilton Laboratories v. Massengill, 111 F.2d 584 (6th Cir. 1940); *Application of Tenney*, 254 F.2d 619, 45 C.C.P.A. 894 (1958); *Garrett Corporation v. United States*, 422 F.2d 874, 878, 190 Ct.Cl. 858 (1970); *Philips Electronic & Pharmaceutical Industries Corp. v. Thermal and Electronics Industries, Inc.*, 450 F.2d 1164 (3rd Cir. 1971); *Popeil Brothers, Inc. v. Schick Electric, Inc.*, 494 F.2d 162 (7th Cir. 1974).

The Garbell Patent in Suit Is Invalid Under 35 U.S.C. §103. The Courts Below Properly Applied the Law Laid Down by the Supreme Court.

In holding the Garbell patent in suit invalid under 35 U.S.C. §103, the courts below properly applied the law laid down by the Supreme Court.

On the issue of obviousness, the Trial Court concluded as follows:

"18. The subject matter of the patent in suit, taken as a whole, would have been obvious to persons of ordinary skill in the art prior to the time of the alleged invention, 35 U.S.C. §103, *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed. 2d 545 (1965); *Walker v. General Motors Corporation*, 362 Fed. 2d 56 (9th Cir. 1966)."

Speaking for the Ninth Circuit in the *Walker* case, *supra*, Judge Browning recited the elements of the obviousness test set out by the Supreme Court in *Graham, supra*:

"As the Supreme Court has recently pointed out, the basic factual background necessary to a determination of section 103 obviousness relates to three matters: (1) 'the scope and content of the

prior art'; (2) 'differences between the prior art and the claims at issue'; and (3) 'the level of ordinary skill in the pertinent art.' *Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684 (1966). [Walker case at 362 F.2d 59.]

The level of ordinary skill in the pertinent art was observed by the Trial Court in Finding G34 to the effect that: "The level of skill in the airframe industry is extraordinary. . . ." Moreover, the court found no critical difference between the example wing disclosed by Zien and a wing covered by Claims 1, 2, 3 and 7 of the patent in suit (G7) and that "there is no critical difference between the geometry of the example wing given by Lachmann and the geometry of wings covered by Claims 1, 2, 3 and 7 of the patent in suit." (G10.) In summary, the conclusion of obviousness of the subject matter of the patent is amply supported in every particularly of the *Graham* test.

The Usual Presumption of Patent Validity Under 35 U.S.C. §282 Is Vitiating in This Case by Reason of the Fact That Garbell Did Not Cite to the Patent Office, and the Patent Office Did Not Consider, the Most Pertinent Prior Art.

The usual presumption of patent validity under 35 U.S.C. §282 is vitiating in this case by reason of the fact that Garbell did not cite to the Patent Office, and the Patent Office did not consider, the most pertinent prior art.

As set forth herein, the most pertinent prior art Pinguini sailplane wing, publicly demonstrated and described in printed publications in the late '30s (by Garbell himself) was not cited to the Patent Office. (See pp. 4-17, 39-40 herein). Garbell deliberately mis-

led Judge Yankwich on the Pinguino and its pertinence (see pp. 14-17 herein).

It was testified to (and not contradicted by Garbell) that while Cronstedt was more pertinent than the other patents cited in the prosecution of the '758 patent in the Patent Office, "these four patents that were cited, are less pertinent than other material such as Lachmann, Tsien, NACA Reports" and the Zacher article written on the D-30 Cirrus sailplane. [Abbott: R.T. 1485-1487.]

The usual presumption of patent validity (35 U.S.C. §282) is vitiating in this case by reason of the fact that the applicant did not cite to the Patent Office, and the Patent Office did not consider, the most pertinent prior art, including the printed publications describing the prior art Pinguino sailplane wing, the Curtiss-Wright Models 23 and 21B airplanes, the Zien article, the Lachmann article, the Lombard article, the Zacher article, and N.A.C.A. Report Nos. 572, 703 and 713, all of which prior art aircraft and references are more pertinent than the references cited by the Patent Office. *Pressteel Co. v. Halo Lighting Products, Inc.*, 314 F.2d 695 (9th Cir. 1963); *Monroe Auto Equipment Company v. Superior Industries, Inc.*, 332 F.2d 473 (9th Cir. 1964); *Henderson v. A. C. Spark Plug Division of General Motors Corp.*, 366 F.2d 389 (9th Cir. 1966); *Groen v. General Foods Corporation*, 402 F.2d 708 (9th Cir. 1968). The patentee is charged with full consequences of all prior knowledge or use by others. *Everlube Corporation of America v. Electrofilm, Inc.*, 154 F.Supp. 788, 803 (D.C.Cal. 1957), opinion adopted on appeal, 265 F.2d 495 (9th Cir. 1959); *Condenser Corporation of America v. Micamold Radio Corp.*, 145 F.2d 878 (2nd

Cir. 1944); *Bone v. Marion County*, 251 U.S. 134, 40 S.Ct. 96, 64 L.Ed. 188 (1919).

Conclusion.

Demonstrably, the facts themselves met, and meet, the questions raised by plaintiffs' petition for a writ of certiorari. The facts set out above, the findings and conclusions, all meet the points raised. Garbell's bad-faith conduct by any standard was willful. The invalidity facts are clear, unequivocal and convincing: the defendants' proof, offered through uncontroverted documents and the testimony of those whose extraordinary skill is found throughout the airframe industry, was not controverted; instead it was augmented by evidence the plaintiffs themselves presented. The trial court's findings, conclusions and judgment could not have been different. After reviewing the extensive trial record, the Ninth Circuit affirmed "in all respects." Defendants thus submit that this case presents no reasons for granting certiorari and earnestly request that these cases be concluded—that the petition be denied.

Respectfully submitted,

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